



DEPARTMENT OF COMMERCE

Patent and Trademark Office

37 CFR Parts 2 and 7

[Docket No. PTO-T-2021-0008]

RIN 0651-AD55

Changes to Implement Provisions of the Trademark Modernization Act of 2020

AGENCY: United States Patent and Trademark Office, Commerce.

ACTION: Notice of proposed rulemaking.

SUMMARY: The United States Patent and Trademark Office (USPTO or Office) proposes to amend the rules of practice in trademark cases to implement provisions of the Trademark Modernization Act of 2020. The proposed rule establishes ex parte expungement and reexamination proceedings for cancellation of a registration when the required use in commerce of the registered mark has not been made; provides for a new nonuse ground for cancellation before the Trademark Trial and Appeal Board; establishes flexible Office action response periods; and amends the existing letter-of-protest rule to indicate that letter-of-protest determinations are final and non-reviewable. The USPTO also proposes to set fees for petitions requesting institution of ex parte expungement and reexamination proceedings, and for requests to extend Office action response deadlines. Amendments are also proposed for the rules concerning the suspension of USPTO proceedings and the rules governing attorney recognition in trademark matters. Finally, a new rule is proposed to address procedures regarding court orders cancelling or affecting registrations.

DATES: Written comments must be received on or before [INSERT DATE 60 DAYS AFTER DATE OF PUBLICATION IN THE FEDERAL REGISTER].

ADDRESSES: For reasons of government efficiency, comments must be submitted through the Federal eRulemaking Portal at www.regulations.gov. To submit comments via the portal, one should enter docket number PTO-T-2021-0008 on the homepage and click “search.” The site will provide search results listing all documents associated with this docket. Commenters can find a reference to this notice and click on the “Comment Now!” icon, complete the required fields, and enter or attach their comments.

Attachments to electronic comments will be accepted in Adobe® portable document format or Microsoft Word® format. Because comments will be made available for public inspection, information that the submitter does not desire to make public, such as an address or phone number, should not be included in the comments.

Visit the Federal eRulemaking Portal for additional instructions on providing comments via the portal. If electronic submission of or access to comments is not feasible due to a lack of access to a computer and/or the internet, please contact the USPTO using the contact information below for special instructions.

FOR FURTHER INFORMATION CONTACT: Robert Lavache, Office of the Deputy Commissioner for Trademark Examination Policy, at 571-272-5881, or by email at TMPolicy@uspto.gov.

SUPPLEMENTARY INFORMATION:

The Trademark Modernization Act of 2020 (TMA) was enacted on December 27, 2020. See Pub. L. No. 116-260, Div. Q, Tit. II, Subtit. B, §§ 221-228 (Dec. 27, 2020).

The TMA amends the Trademark Act of 1946 (the Act) to establish new *ex parte* expungement and reexamination proceedings to cancel, either in whole or in part, registered marks for which the required use in commerce was not made. *Id.* at § 225(a), (c). Furthermore, the TMA amends § 14 of the Act to allow a party to allege that a mark has never been used in commerce as a basis for cancellation before the Trademark Trial and Appeal Board (TTAB). *Id.* at § 225(b). The TMA also authorizes the USPTO to

promulgate regulations to set flexible Office action response periods between 60 days and 6 months, with an option for applicants to extend the deadline up to a maximum of 6 months from the Office action issue date. *Id.* at § 224. In addition, the TMA includes statutory authority for the USPTO’s letter-of-protest procedures, which allow third parties to submit evidence to the USPTO relevant to a trademark’s registrability during the initial examination of the trademark application, and provides that the decision whether to include such evidence in the application record is final and non-reviewable. *Id.* at § 223. The TMA requires the USPTO to promulgate regulations to implement the provisions relating to the new ex parte expungement and reexamination proceedings, and the letter-of-protest procedures, within one year of the TMA’s enactment. *Id.* at §§ 223(b), 225(f).

Accordingly, the USPTO proposes to revise the rules in 37 CFR parts 2 and 7 to implement the TMA’s provisions and set fees for the new ex parte expungement and reexamination proceedings and for response deadline extensions. The proposed rule is also intended to clarify that the new ex parte expungement and reexamination proceedings are subject to suspension in appropriate cases and to ensure that the rules reflect existing practice regarding suspension of proceedings before the USPTO and the TTAB. The USPTO also proposes to amend the rules regarding attorney recognition and correspondence to allow attorney recognition to continue until it is revoked or the attorney withdraws. This change is proposed to align the rules with current USPTO practice and facilitate implementation of a role-based access control system intended to improve USPTO database security and integrity. Finally, the USPTO proposes to add a new rule formalizing the USPTO’s longstanding procedures concerning action on court orders cancelling or affecting a registration under section 37 of the Act, 15 U.S.C. 1119.

I. Ex Parte Expungement and Reexamination Proceedings

As the House Report for the TMA explained, “[t]rademarks are at the foundation of a successful commercial marketplace. Trademarks allow companies to identify their goods and services, and they ensure that consumers know whose product they are buying. . . . By guarding against deception in the marketplace, trademarks also serve an important consumer protection role.” H. Rep. No. 116-645, at 8-9 (2020) (citation omitted).

In order to have a well-functioning trademark system, the trademark register should accurately reflect trademarks that are currently in use. *Id.* at 9. When the register includes marks that are not currently in use, it is more difficult for legitimate businesses to clear and register their own marks. *Id.* It has become apparent in recent years that registrations are being obtained and maintained for marks that are not properly in use in commerce. *Id.* at 9-10. Moreover, this “cluttering” has real-world consequences when the availability of marks is depleted. *Id.* at 9.

The House Report also noted that “[a] recent rise in fraudulent trademark applications has put further strain on the accuracy of the federal register. . . . Although trademark applications go through an examination process, some of these forms of fraud are difficult to detect in individual applications (even if patterns of fraud can be seen across multiple applications), leading to illegitimate registrations. Although the USPTO can try to develop better systems to detect fraud during the examination process, its authority to reconsider applications after registration is currently limited.” *Id.* at 10-11 (citation omitted).

To address these problems, the TMA created two new *ex parte* processes that will allow a third party, or the Director, to challenge whether a registrant made use of its registered trademark in commerce. If the registered mark was not properly used, the Office will be able to cancel the registration. *Id.* at 11. The TMA also provided for improvements to make the trademark examination process more efficient and more

effective at clearing applications that may block later-filed applications from proceeding to registration. *Id.*

The two new *ex parte* proceedings created by the TMA—one for expungement and one for reexamination—are intended to help ensure the accuracy of the trademark register by providing a new mechanism for removing a registered mark from the trademark register, or cancelling the registration as to certain goods and/or services, when the registrant has not used the mark in commerce as of the relevant date as required by the Act. In an expungement proceeding, the USPTO must determine whether the evidence of record supports a finding that the registered mark has never been used in commerce on or in connection with some or all of the goods and/or services recited in the registration. In a reexamination proceeding, the USPTO must determine whether the evidence of record supports a finding that the mark registered under section 1 of the Act was not in use in commerce on or in connection with some or all of the goods and/or services as of the filing date of the application or amendment to allege use, or before the deadline for filing a statement of use, as applicable. If the USPTO finds that the required use was not made for the goods or services at issue in the proceeding, and that determination is not overturned on review, the registration will be cancelled in whole or in part, as appropriate.

These new proceedings are intended to provide a faster, more efficient, and less expensive alternative to a contested *inter partes* cancellation proceeding before the TTAB. While the authority for the expungement and reexamination proceedings is set forth in separate subsections of the Act, the procedures for instituting the proceedings, the nature of the evidence required, and the process for evaluating evidence and corresponding with the registrant will be essentially the same. Thus, for administrative efficiency, proceedings involving the same registration may be consolidated by the USPTO for review.

To implement these new proceedings and related procedures, as required by the TMA, the USPTO proposes the following new rules:

- Section 2.91, setting forth the requirements for a petition requesting the institution of expungement or reexamination proceedings;
- Section 2.92, regarding the institution of expungement and reexamination proceedings;
- Sections 2.93 through 2.94, setting forth the procedures for expungement and reexamination proceedings; and
- Section 2.143, addressing appeals to the TTAB in connection with these new proceedings.

In addition, conforming amendments are proposed for the following existing rules:

- Section 2.11, which requires U.S. counsel for foreign-domiciled petitioners and registrants;
- Section 2.23, which addresses the duty to monitor the status of a registration;
- Section 2.142, which addresses the time and manner of ex parte appeals;
- Section 2.145, which addresses appeals to the U.S. Court of Appeals for the Federal Circuit;
- Section 2.146, which addresses petitions to the Director; and
- Section 2.193, which addresses signature requirements.

A. Timing for Requests for Proceedings

The TMA specifies the time periods during which a petitioner can request institution of expungement and reexamination proceedings, and during which the Director may institute such proceedings based on a petition or on the Director's own initiative. Accordingly, under proposed § 2.91(b)(1), a petitioner may request, and the Director may institute, an ex parte expungement proceeding between 3 and 10 years

following the date of registration. However, the TMA provides that, until December 27, 2023 (3 years from the TMA's enactment date), a petitioner may request, and the Director may institute, an expungement proceeding for a registration that is at least 3 years old, regardless of the 10-year limit. Under proposed § 2.91(b)(2), a petitioner may request, and the Director may institute, a reexamination proceeding during the first five years following the date of registration.

The TMA gives discretion to the Director to establish by rule a limit on the number of petitions for expungement or reexamination that can be filed against a registration. However, it is envisioned that the USPTO will not initially propose such a limitation to foster clearing of the register of unused marks and also to determine whether existing safeguards in the statute and the proposed regulations suffice to protect registrants from potential misuse of the proceedings. These safeguards include the fact that the registrant does not participate until after the Director institutes a proceeding based on a prima facie case of nonuse of the mark, and the registrant cannot be subject to another proceeding for the same goods and/or services for which use of the mark was established in a prior proceeding. If the existing safeguards in the statute and the proposed regulations do not suffice to protect registrants from misuse of the proceedings, the USPTO may establish a limit on the number of petitions for expungement or reexamination that can be filed against a registration. The USPTO seeks comment on this approach.

B. Petition Requirements

Under the TMA, and proposed § 2.91, any person may file a petition with the USPTO requesting institution of an expungement or reexamination proceeding. Although the USPTO does not anticipate requiring real-party-in-interest information from the petitioner, the USPTO is seeking comments on whether and when the Director should

require a petitioner to identify the name of the real party in interest on whose behalf the petition is filed.

Reexamination and expungement petitions are intended to allow third parties to bring unused registered marks to the attention of the USPTO. To the extent a registrant believes its own mark was not used in commerce, or is no longer used in commerce, on or in connection with some or all of the goods and/or services listed in the registration, the registrant should utilize the existing mechanisms for voluntarily amending the registration to delete the goods and/or services or surrendering the registration in its entirety, pursuant to section 7 of the Act, 15 U.S.C. 1057. To incentivize registrants to keep their registrations accurate and up to date as to the goods and/or services on which the mark is actually used in commerce, the USPTO established a \$0 fee for voluntary deletions of goods and/or services made outside of a maintenance examination as of January 2, 2021, in the Trademark Fee Adjustment rule (85 FR 73197, November 17, 2020).

A petition for expungement must allege that the relevant registered trademark has never been used in commerce on or in connection with some or all of the goods and/or services listed in the registration.

A petition for reexamination must allege that the trademark was not in use in commerce on or in connection with some or all of the goods and/or services listed in the registration on or before the relevant date, which, for any particular goods and/or services, is determined as follows:

- In a use-based application for registration of a mark with an initial filing basis of section 1(a) of the Act for the goods and/or services listed in the petition, and not amended at any point to be filed pursuant to section 1(b) of the Act, 15 U.S.C. 1051(b), the relevant date is the filing date of the application; or

- In an intent to use application for registration of a mark with an initial filing basis or amended basis of section 1(b) of the Act for the goods and/or services listed in the petition, the relevant date is the later of the filing date of an amendment to allege use identifying the goods and/or services listed in the petition, pursuant to section 1(c) of the Act, or the expiration of the deadline for filing a statement of use for the goods and/or services listed in the petition, pursuant to section 1(d), including all approved extensions thereof.

Under proposed § 2.91(c), the Director will consider only complete petitions for expungement or reexamination. To be considered complete, the petition must be made in writing and filed through the USPTO's Trademark Electronic Application System (TEAS), and must include:

- (1) The fee required under proposed § 2.6(a)(26);
- (2) The U.S. trademark registration number corresponding to the registration that is the subject of the petition;
- (3) The basis for the petition under proposed § 2.91(a);
- (4) The name, domicile address, and email address of the petitioner;
- (5) If the domicile of the petitioner is not located within the United States or its territories, a designation of an attorney, as defined in § 11.1, who is qualified to practice under § 11.14;
- (6) If the petitioner is, or must be, represented by an attorney, as defined in § 11.1, who is qualified to practice under § 11.14, the attorney's name, postal address, email address, and bar information under § 2.17(b)(3);
- (7) Identification of each good and/or service recited in the registration for which the petitioner requests that the proceeding be instituted on the basis identified in the petition;
- (8) A verified statement that sets forth in numbered paragraphs:

- (i) The elements of the reasonable investigation of nonuse the petitioner conducted, and, for each source of information relied upon, a description of how and when the searches were conducted and what the searches disclosed;
 - (ii) A concise factual statement of the relevant basis for the petition, including any additional facts that support the allegation of nonuse of the mark in commerce on or in connection with the relevant goods and services; and
- (9) A clear and legible copy of all documentary evidence supporting a prima facie case of nonuse of the mark in commerce and an itemized index of such evidence.

If a petition does not satisfy the requirements for a complete petition, the USPTO plans to issue a letter providing the petitioner 30 days to perfect the petition by complying with the outstanding requirements, if otherwise appropriate.

C. Petition Fee

Proposed § 2.6(a)(26) sets a fee of \$600, per class, for a petition for expungement or reexamination. In setting this fee, the USPTO intends to strike a balance between recovering the costs associated with conducting these proceedings (including Director-initiated proceedings) and providing a less expensive alternative to a contested inter partes cancellation proceeding before the TTAB.

D. Reasonable Investigation Requirement

Under proposed § 2.91(c), a petition requesting institution of an expungement or reexamination proceeding must include a verified statement that sets forth the elements of the reasonable investigation the petitioner conducted to determine that the mark was never used in commerce (for expungement petitions) or not in use in commerce as of the relevant date (for reexamination petitions) on or in connection with the goods and/or services identified in the petition.

A reasonable investigation is an appropriately comprehensive search likely to reveal use of the mark in commerce on or in connection with the relevant goods and/or

services, if such use was, in fact, made. Thus, what constitutes a reasonable investigation is a case-by-case determination, but any investigation should focus on the mark disclosed in the registration and the identified goods and/or services, keeping in mind their scope and applicable trade channels.

The elements of a petitioner's investigation should demonstrate that a search for use in relevant channels of trade and advertising for the identified goods and/or services did not reveal any relevant use. In addition, the petitioner's statement regarding the elements of the reasonable investigation should specifically describe the sources searched, how and when the searches were conducted, and what information and evidence, if any, the searches produced.

Sources of information and evidence should include reasonably accessible sources that can be publicly disclosed, because petitions requesting institution of expungement and reexamination proceedings will be entered in the registration record and thus publicly viewable through the USPTO's Trademark Status & Document Retrieval (TSDR) database. The number and nature of the sources a petitioner must check in order for its investigation to be considered reasonable, and the corresponding evidence that would support a prima facie case, will vary depending on the goods and/or services involved, their normal trade channels, and whether the petition is for expungement or reexamination. Because nonuse for purposes of expungement and reexamination is necessarily determined in reference to a time period that includes past activities (not just current activities), a petitioner's investigation normally would include research into past usage of the mark for the goods and/or services at issue in the petition and thus may include archival evidence.

As a general matter, a single search using an internet search engine likely would not be considered a reasonable investigation. See H. Rep. No. 116-645, at 15 (2020). On the other hand, a reasonable investigation does not require a showing that all of the

potentially available sources of evidence were searched. Generally, an investigation that produces reliable and credible evidence of nonuse at the relevant time should be sufficient.

As set forth in proposed § 2.91(d)(2), appropriate sources of evidence and information for a reasonable investigation may include, but are not limited to:

- State and Federal trademark records;
- Internet websites and other media likely to or believed to be owned or controlled by the registrant;
- Internet websites, other online media, and publications where the relevant goods and/or services likely would be advertised or offered for sale;
- Print sources and webpages likely to contain reviews or discussion of the relevant goods and/or services;
- Records of filings made with or of actions taken by any State or Federal business registration or regulatory agency;
- The registrant's marketplace activities, including, for example, any attempts to contact the registrant or purchase the relevant goods and/or services;
- Records of litigation or administrative proceedings reasonably likely to contain evidence bearing on the registrant's use or nonuse of the registered mark; and
- Any other reasonably accessible source with information establishing that the mark was never in use in commerce (expungement), or was not in use in commerce as of the relevant date (reexamination), on or in connection with the relevant goods and/or services.

A petitioner is not required or expected to commission a private investigation, but may choose to generally reference the results of any report from such an investigation, without disclosing specific information that would waive any applicable privileges.

Finally, any party practicing before the USPTO, including those filing petitions to request institution of these ex parte proceedings, is bound by all ethical rules involving candor toward the USPTO as the adjudicating tribunal. Of particular relevance in expungement and ex parte reexamination proceedings is 37 CFR 11.303(d), which provides: “In an ex parte proceeding, a practitioner shall inform the tribunal of all material facts known to the practitioner that will enable the tribunal to make an informed decision, whether or not the facts are adverse.”

E. Director-Initiated Proceedings

As authorized by the TMA, proposed § 2.92(b) provides that the Director may, within the time periods set forth in proposed § 2.91(b), institute an expungement or reexamination proceeding on the Director’s own initiative, if the information and evidence available to the USPTO supports a prima facie case of nonuse.

Proposed § 2.92(e)(1) provides that, for efficiency and consistency, the Director may consolidate proceedings (including a Director-initiated proceeding with a petition-initiated proceeding). Consolidated proceedings are related parallel proceedings that may include both expungement and reexamination grounds.

In addition, under proposed § 2.92(e)(2), if two or more petitions under proposed § 2.91 are directed to the same registration and are pending concurrently (i.e., expungement or reexamination proceedings based on these petitions are not yet instituted), or the Director wishes to institute an ex parte expungement or reexamination proceeding on the Director’s own initiative under proposed § 2.92(b) concerning a registration for which one or more petitions under § 2.91 are pending, the Director may elect to institute a single proceeding.

F. Establishing a Prima Facie Case

Under proposed § 2.92, as provided for explicitly in the TMA, an expungement or reexamination proceeding will be instituted only in connection with the goods and/or services for which a prima facie case of relevant nonuse has been established. *See* Pub. L. No. 116-260, Div. Q, Tit. II, Subtit. B, § 225(a), (c). For the purpose of the proposed rule, a “prima facie case” requires only that a reasonable predicate concerning nonuse be established. *See* H. Rep. No. 116-645, at 8, citing *In re Pacer Tech.*, 338 F.3d 1348, 1351 (Fed. Cir. 2003) and *In re Loew’s Theatres, Inc.*, 769 F.2d 764, 768 (Fed. Cir. 1985). Thus, with respect to these proceedings, a prima facie case includes sufficient notice of the claimed nonuse to allow the registrant to respond to and potentially rebut the claim with competent evidence, which the USPTO must then consider before making a determination as to whether the registration should be cancelled in whole or in part, as appropriate.

For expungement and reexamination proceedings instituted based on a petition under proposed § 2.91, the determination of whether a prima facie case has been made is based on the evidence and information that is collected as a result of the petitioner’s reasonable investigation and set forth in the petition along with the USPTO’s electronic record of the involved registration. Appropriate sources of such evidence and information include those listed in proposed § 2.91(d)(2).

For Director-initiated expungement and reexamination proceedings, the evidence and information that may be relied upon to establish a prima facie case may be from essentially the same sources as in the petition-initiated proceeding.

G. Notice of Petition and Proceedings

When a petitioner files a petition requesting institution of expungement or reexamination proceedings, the petition will be uploaded into the registration record and viewable through TSDR. The USPTO plans to send a courtesy email notification to the

registrant and/or registrant's attorney, as appropriate, if a valid email address is of record. The registrant may not respond to this courtesy notice. No response from the registrant will be accepted unless and until the Director institutes a proceeding under proposed § 2.92.

Once the Director has determined whether to institute a proceeding based on the petition, notice of that determination will be sent to the petitioner and the registrant, along with the means to access the petition and supporting documents and evidence.

If a proceeding is instituted, the petitioner will not have any further involvement. In the case of Director-initiated proceedings, there is no petitioner, and thus all relevant notices will be provided only to the registrant. In both types of proceedings, official documents associated with the proceeding will be uploaded into the registration record and will be publicly viewable through TSDR.

Under the TMA and proposed § 2.92(c)(1), any determination by the Director whether to institute an expungement or reexamination proceeding, based either on a petition or on the Director's own initiative, is final and non-reviewable. See Pub. L. No. 116-260, Div. Q, Tit. II, Subtit. B, § 225(a), (c).

Finally, for purposes of correspondence relating to these proceedings, the "registrant" is the owner/holder currently listed in USPTO records.

H. Procedures for Expungement and Reexamination Proceedings

Under proposed § 2.92(f), a proceeding is instituted by notifying the registrant through an Office action, which, in accordance with proposed § 2.93(a), will require the registrant to provide such evidence of use, information, exhibits, affidavits, or declarations as may be reasonably necessary to rebut the prima facie case by establishing that the required use in commerce has been made on or in connection with the goods and/or services at issue as required by the Act. While institution necessitates a response

from the registrant that includes evidence rebutting the prima facie case, the ultimate burden of proving nonuse by a preponderance of the evidence remains with the Office.

Although the Office action will be substantively limited in scope to the question of use in commerce, the registrant will also be subject to the requirements of §§ 2.11 (requirement for representation), 2.23 (requirement to correspond electronically), and 2.189 (requirement to provide a domicile address). Thus, the USPTO will require the registrant to furnish domicile information to determine whether the registrant is required to be represented by a U.S.-licensed attorney. In addition, all registrants will be required to provide a valid email address for correspondence, if one is not already in the record, and to update the email address as necessary to facilitate communication with the USPTO.

The TMA provides that any documentary evidence of use provided by the registrant need not be the same as that required under the USPTO's rules of practice for specimens of use under section 1(a) of the Act, 15 U.S.C. 1051(a), but must be consistent with the definition of "use in commerce" set forth in section 45 of the Act, 15 U.S.C. 1127, and in relevant case law. Although testimonial evidence may be submitted, it should be supported by corroborating documentary evidence.

The expected documentary evidence of use in most cases will, in fact, take the form of specimens of use, but the TMA contemplates situations where, for example, specimens for particular goods and/or services are no longer available, even if they may have been available at the time the registrant filed an allegation of use. In these cases, the registrant may be permitted to provide additional evidence and explanations supported by declaration to explain how the mark was used in commerce at the relevant time. As a general matter, because the registration file, including any specimens, already has been considered in instituting the proceeding based on a prima facie case of nonuse, merely resubmitting the same specimen of use previously submitted prior to registration or a

verified statement alone, without additional supporting evidence, will likely be insufficient to rebut a prima facie case of nonuse.

For expungement proceedings, the registrant's evidence of use must show that the use occurred before the filing date of the granted petition to expunge under § 2.91(a), or before the date the proceeding was instituted by the Director under § 2.92(b), as appropriate. For reexamination proceedings, the registrant's evidence of use must demonstrate use of the mark on or in connection with the goods and/or services at issue on or before the relevant date established under the TMA and the relevant section of the Act.

Under proposed § 2.93(b)(4)(ii), a registrant in an expungement proceeding may provide verified statements and evidence to establish that any nonuse as to particular goods and/or services with a sole registration basis under section 44(e) of the Act, 15 U.S.C. 1126(e), or section 66(a) of the Act, 15 U.S.C. 1141f(a), is due to special circumstances that excuse such nonuse, as set forth in § 2.161(a)(6)(ii). However, excusable nonuse will not be considered for any goods and/or services registered under section 1 of the Act, 15 U.S.C. 1051.

Proposed § 2.93(d) provides that a registrant in an expungement or reexamination proceeding may also respond to an Office action by deleting some or all of the goods and/or services at issue in the proceeding and that an acceptable deletion will be immediately effective. The proposed rule further specifies that no other amendment to the identification of goods and/or services in a registration will be permitted as part of the proceeding. If goods and/or services that are subject to an expungement or reexamination proceeding are deleted after the filing, and before the acceptance, of an affidavit or declaration under section 8 or 71 of the Act, the deletion will be subject to the fee under § 2.161(c) or § 7.37(c).

In addition, a registrant may submit a request to surrender the subject registration for cancellation under § 2.172 or a request to amend the registration under § 2.173, but the mere filing of these requests will not constitute a sufficient response to an Office action requiring the registrant to provide evidence of use of the mark in the expungement or reexamination proceeding. The registrant must affirmatively notify the Office of the separate request in a timely response to the Office action.

Any deletion of goods and/or services at issue in a pending proceeding requested in a response, a surrender for cancellation under § 2.172, or an amendment of the registration under § 2.173, shall render the proceeding moot as to those goods and/or services, and the Office will not make any further determination regarding the registrant's use of the mark in commerce as to those goods and/or services.

Under proposed § 2.93(b)(1), the registrant must respond to the initial Office action via TEAS within two months of the issue date. If the registrant fails to timely respond, the proposed rule provides that the USPTO will terminate the proceedings and the registration will be cancelled, in whole or in part, as appropriate. However, a registrant may request reinstatement of the registration and resumption of the proceeding if the registrant failed to respond to the Office action because of an extraordinary situation. Under proposed § 2.146(d)(2)(iv), such a petition must be filed no later than two months after the date of actual knowledge of the cancellation of goods and/or services in a registration and not later than six months after the date of cancellation as indicated in TSDR. Proposed § 2.146(c)(2) requires the registrant to include a response to the Office action with the petition.

Relatedly, proposed § 2.23(d)(3) provides that registrants are responsible for monitoring the status of their applications and registrations in the USPTO's electronic systems at least every two months after notice of the institution of an expungement or reexamination proceeding until a notice of termination issues under § 2.94, or, if no

notice of institution was received, at least every six months following the issue date of the registration.

The USPTO is also considering whether proposed § 2.93 should provide that, when a timely response by the registrant is a bona fide attempt to advance the proceeding and is a substantially complete response to the Office action, but consideration of some matter or compliance with a requirement has been omitted, the registrant may be granted thirty days, or to the end of the response period set forth in the Office action to which the substantially complete response was submitted, whichever is longer, to resolve the issue before the question of terminating the proceeding is considered. The USPTO seeks comments on whether to include this provision.

In addition, the USPTO is considering whether it should take additional action when a registrant's failure to respond in an expungement or reexamination proceeding leads to cancellation of some of the goods and/or services in the registration. Specifically, the USPTO is considering whether, in these cases, the registration should also be selected for audit under 37 CFR 2.161(b) or 7.37(b) if a registration maintenance filing is pending or, if one is not pending, when the next maintenance filing is submitted. As under current practice, if selected for audit, the registrant would be required to substantiate use for some or all of the remaining goods and/or services recited in the registration. The USPTO seeks comments on this alternative.

If the registrant timely responds to the initial Office action in the expungement or reexamination proceeding, the USPTO will review the response to determine if use of the mark in commerce at the relevant time has been established for each of the goods and/or services at issue. If the USPTO finds during the course of the proceeding that the registrant has demonstrated relevant use of the mark in commerce on or in connection with the goods and/or services at issue sufficient to rebut the prima facie case, demonstrated excusable nonuse in appropriate expungement cases, or deleted the relevant

goods and/or services, such that no goods and/or services remain at issue, the USPTO will issue a notice of termination under proposed § 2.94, the proceeding will be terminated, and the registration will not be cancelled.

If, however, the response fails to establish use of the mark in commerce at the relevant time (or excusable nonuse, if applicable) for all of the goods and/or services at issue, or otherwise fails to comply with all outstanding requirements, the USPTO will issue a final action. In an expungement proceeding, the final action will include the examiner's decision that the registration should be cancelled for each good or service for which the mark was determined to have never been used in commerce or for which no excusable nonuse was established. In a reexamination proceeding, the final action will include the examiner's decision that the registration should be cancelled for each good and/or service for which it was determined the mark was not in use in commerce on or before the relevant date. As appropriate, in either an expungement or reexamination proceeding, the final action will include the examiner's decision that the registration should be cancelled in whole for noncompliance with any requirement under §§ 2.11, 2.23, and 2.189.

If a final action is issued, the registrant will have two months to file a request for reconsideration or an appeal to the TTAB, if appropriate. In accordance with proposed §§ 2.93(c)(3)(ii) and 2.94, if the registrant fails to timely appeal or file a request for reconsideration that establishes use of the mark in commerce at the relevant time for all goods and/or services that remain at issue in a final action (or that deletes the relevant goods and/or services), the USPTO will issue a notice of termination of the proceeding, clearly setting forth the goods and/or services for which relevant use was, or was not, established, as well as any other additional outstanding requirements. The notice of termination is a statement intended to provide notice to the registrant and the public of the ultimate outcome of the proceedings and is not itself reviewable. The USPTO will

also issue, as appropriate, an order cancelling the registration in whole or in part in accordance with the examiner's decision in the final action. The proposed rule provides that, if the registrant fails to timely respond, the USPTO will terminate the proceedings, and the registration will be cancelled, in whole or in part, as appropriate. However, a registrant may request reinstatement of the registration and resumption of the proceeding if the registrant failed to respond to the Office action because of an extraordinary situation. Under proposed § 2.146(d)(2)(iv), such a petition must be filed no later than two months after the date of actual knowledge of the cancellation of goods and/or services in a registration and may not be filed later than six months after the date of cancellation in TSDR. Proposed § 2.146(c)(2) requires the registrant to include a response to the Office action with the petition.

Under proposed § 2.94, if the required use in commerce (or excusable nonuse, in appropriate cases) is not established, the notice of termination will indicate a cancellation of either some of the goods and/or services or the entire registration, depending on the circumstances. If the goods and/or services for which use (or excusable nonuse) was not demonstrated are the only goods and/or services in the registration, or there remain any additional outstanding requirements, the whole registration will be cancelled. However, if the notice of termination relates only to a portion of the goods and/or services in the registration, and there are no other outstanding requirements, the registration will be cancelled in part, as appropriate. A notice of termination will not issue until all outstanding issues are satisfactorily resolved (and thus no cancellation is necessary) or the time for appeal has expired or any appeal proceeding has terminated. Petitioners and other interested parties may monitor the progress of a proceeding by reviewing the status and associated documents through TSDR.

In setting the proposed deadlines for expungement and reexamination proceedings, the USPTO considered the amount of time a registrant might need in order

to research and collect relevant evidence of use, as well as the fact that some proceedings may involve more goods and/or services than others. The USPTO also weighed these considerations against the goal that these proceedings be faster and more efficient than other available options for cancellation of registrations for marks not used with goods and/or services listed therein, as well as the fact that most registrants are likely to have evidence of use that is contemporaneous with the relevant date at issue.

I. Estoppel and Co-pending Proceedings

Proposed § 2.92(d) includes provisions for estoppel and bars co-pending proceedings involving the same registration and the same goods and/or services.

Specifically, proposed § 2.92(d)(1) provides that, upon termination of an expungement proceeding, including after any appeal, where it has been established that the registered mark was used in commerce on or in connection with any of the goods and/or services at issue in the proceedings prior to the date a petition to expunge was filed under proposed § 2.91 or the Director-initiated proceedings were instituted under proposed § 2.92, no further expungement proceedings may be instituted as to those particular goods and/or services. Subsequent reexamination proceedings for marks registered under section 1 of the Act are not barred under these circumstances because reexamination proceedings involve a question of whether the mark was in use in commerce as of a particular relevant date, whereas earlier expungement proceedings would only have involved a determination of whether the mark was never used. Proof of use sufficient to rebut a prima facie case of nonuse in an expungement proceeding might not establish use as of a particular relevant date, as required in a reexamination proceeding.

Proposed § 2.92(d)(2) provides that, upon termination of a reexamination proceeding, including after any appeal, where it is determined that the registered mark was used in commerce on or in connection with any of the goods and/or services at

issue, on or before the relevant date at issue in the proceedings, no further expungement or reexamination proceedings may be instituted as to those particular goods and/or services. The TMA does not explicitly bar a subsequent expungement proceeding following a determination in a reexamination proceeding. However, the rule takes into account that it would be unnecessary for the registrant to be subjected to a later-instituted proceeding alleging the mark was never used in commerce when the USPTO has already determined that the mark was used in commerce on or before the relevant date.

In addition, proposed § 2.92(d)(3) provides that, with respect to a particular registration, while an expungement proceeding is pending, no later expungement proceeding may be instituted with respect to the same goods and/or services at issue in the pending proceeding. Proposed § 2.92(d)(4) establishes that, with respect to a particular registration, while a reexamination proceeding is pending, no later expungement or reexamination proceeding may be instituted with respect to the same goods and/or services at issue in the pending proceeding.

For the purposes of these rules, the wording “same goods and/or services” refers to identical goods and/or services that are the subject of the pending proceeding or the prior determination. Thus, for example, if a subsequent petition for reexamination identifies goods that are already the subject of a pending reexamination proceeding and goods that are not, only the latter goods could potentially be the subject of a new proceeding. The fact that there is some overlap between the goods and/or services in the pending proceeding and those identified in a petition would not preclude the goods and/or services that are not the same from being the subject of a new proceeding, if otherwise appropriate. This situation is addressed in proposed rule § 2.92(c)(2), which permits the Director to institute a proceeding on petition for fewer than all of the goods and/or services identified in the petition.

II. New Nonuse Ground for Cancellation Before the TTAB

The TMA created a new nonuse ground for cancellation under section 14 of the Act, allowing a petitioner to allege that a mark has never been used in commerce as a basis for cancellation before the TTAB. This ground is available at any time after the first three years from the registration date. Therefore, the USPTO proposes amending § 2.111(b) to indicate when a petition on this ground may be filed and to distinguish it from the timing of other nonuse claims.

III. Flexible Response Periods

The TMA amended section 12(b) of the Act, 15 U.S.C. 1062(b), to allow the USPTO to set response periods by regulation for a time period between 60 days and 6 months, with the option for extensions to a full 6-month period. Under current § 2.62(a), applicants have six months to respond to Office actions issued during examination of a trademark application. Many examination issues, particularly formal requirements like amendments to identifications or mark descriptions, can be resolved well before the current six-month deadline. However, the USPTO also recognizes that Office actions containing statutory refusals may present complex issues that require more time to address, and thus applicants and their attorneys may need the full response period to prepare and submit a response.

USPTO data analytics indicate that, in fiscal year (FY) 2020, 42% of represented applicants and 66% of unrepresented applicants responded to an Office action with a single substantive ground of refusal within three months from the issuance of a non-final Office action. Where the Office action covered multiple refusals, 31% of represented applicants and 56% of unrepresented applicants responded within three months.

Accordingly, the USPTO proposes amending § 2.62 to set a response period of three months for responses to Office actions in applications under sections 1 and/or 44 of the Act. Under proposed § 2.62(a)(2), applicants may request a single three-month extension of this three-month deadline, subject to payment of the fee in proposed

§ 2.6(a)(27), namely, \$125 for an extension request filed through TEAS and \$225 for a permitted paper-filed request. To be considered timely, the request for an extension must be received by the USPTO on or before the deadline for response, which, consistent with current examination practice, will be set forth in the Office action. If an applicant fails to respond or request an extension within the specified time period, the application will be abandoned. This extension will not affect the existing practice under § 2.65(a)(2) that permits an examiner to grant an applicant 30 days, or to the end of the response period set forth in the action to which a substantially complete and timely response was submitted, whichever period is longer, to explain or supply an omission. The proposed amendments to § 2.66 address the requirement for the extension fee in situations where an applicant files a petition to revive past a three-month deadline.

Although post-registration actions are not subject to the response provisions in section 12 of the Act, for convenience and predictability, the USPTO proposes to have the same three-month response period and single three-month extension apply to Office actions issued in connection with post-registration review of registration maintenance and renewal filings.

However, applications under section 66(a) of the Act will not be subject to the three-month deadline for Office action responses; the deadline will instead remain at six months. USPTO data analytics indicate that in FY 2020, only 11% of Madrid applicants filed a response to a non-final Office action with multiple grounds within three months, while 62% of Madrid applicants took six months to file a response. The additional processing required for these applications, both at the USPTO and the World Intellectual Property Organization's International Bureau, per article 5(2) of the Madrid Protocol, introduces time constraints that justify maintaining the current deadlines.

These flexible response periods are intended to promote efficiency in examination by shortening the prosecution timeline for applications with issues that are relatively

simple to address, while providing sufficient time, through an optional extension, for responses to Office actions with more complex issues. In addition, shorter response periods may result in faster disposal of applications and thus reduce the potential delay in examination of later-filed applications for similar marks.

The proposed rule includes conforming revisions to §§ 2.63, 2.65, 2.66, 2.141, 2.142, 2.163, 2.165, 2.184, 2.186, 7.6, 7.39, and 7.40 to account for the proposed deadlines and extensions.

These flexible response periods and extensions will likely involve significant changes to examination processes and the USPTO's information technology (IT) systems. Although the rules regarding expungement and reexamination proceedings must be implemented within one year of the TMA's enactment, there is no required date of implementation for the flexible response and extension provisions. The Office proposes a delayed implementation date of June 27, 2022, in order to allow customers to update their practices and IT systems for these changes. The USPTO seeks comments on this approach.

Finally, the USPTO is seeking comments on two alternatives to the procedures proposed above. One alternative under consideration is a two-phase examination system, with each phase having separate shortened, but extendable, response periods. This alternative may allow more flexibility in setting response periods to promote efficiency in examination to address the recent increase in applications. For example, a USPTO examiner could review application formalities and issue a formalities Office action with a shortened response period of two months, extendable in two-month increments to a full six months upon request and payment of a fee. Once the formalities are addressed, the application could enter the second phase of the examination, whereby an examiner would issue an Office action, containing any substantive refusals, that identifies a response

deadline of the time of three months, extendable for another three months to a total of six months, upon request and payment of a fee.

The other alternative under consideration is to set the initial period for responding to an Office action at two months, but allow applicants to file a response in the third, fourth, fifth, or sixth month after issuance of the Office action by submitting an extension request and fee payment along with the response. The fee for extension would be progressively higher the later the filing of the response and extension request. For example, responses filed in the third, fourth, fifth, and sixth month after issuance of the Office action would have an extension fee of \$50, \$75, \$125, and \$150, respectively. An application would be abandoned when a response is not received within the two-month period or such other extended deadline as requested and paid for by applicant, not to exceed six months from the Office action issue date. If an application abandons, the applicant may submit a petition to revive the application that must include the applicable petition fee and the appropriate extension fee. For example, if the petition to revive is filed in the fifth month after the Office action issues, the extension fee would be \$125. If the petition is filed in the sixth month or later, the extension fee would be \$150. The USPTO seeks comments on these alternatives.

IV. Letters of Protest

The TMA amends section 1 of the Act, 15 U.S.C. 1051, to add a new paragraph (f), providing express statutory authority for the USPTO's existing letter-of-protest procedure, which allows third parties to submit to the USPTO for consideration and entry into the record evidence bearing on the registrability of a mark. This procedure is intended to aid in examination without causing undue delay or compromising the integrity and objectivity of the ex parte examination process. The TMA also provides that the Director shall determine whether evidence should be included in the record of the

relevant application within two months of the date on which a letter-of-protest submission is filed.

The USPTO promulgated letter-of-protest procedures at 37 CFR 2.149 in a final rule published in the Federal Register on November 17, 2020 (85 FR 73197). The requirements set out in § 2.149 are consistent with those in the TMA. However, the TMA further provides that any determination by the Director of the USPTO whether to include letter-of-protest evidence in the record of an application shall be final and non-reviewable, and that such a determination shall not prejudice any party's right to raise any issue and rely on any evidence in any other proceeding. *See* Pub. L. No. 116-260, Div. Q, Tit. II, Subtit. B, § 223(a) (Dec. 27, 2020). The USPTO proposes to revise § 2.149 to include these additional provisions.

The TMA also authorizes the USPTO to charge a fee for letters of protest. *Id.* Under existing § 2.6(a)(25), the USPTO currently charges \$50 per letter-of-protest submission. That fee is not changed in this proposed rulemaking.

V. Suspension of Proceedings

The USPTO proposes to revise §§ 2.67 and 2.117 to clarify that expungement and reexamination proceedings are included among the types of proceedings for which suspension of action by the Office or the TTAB is authorized. In addition, the USPTO proposes to revise these rules to align them with the existing practice regarding suspension of proceedings before the USPTO or the TTAB. Generally, the USPTO will suspend prosecution of a trademark application or a matter before the TTAB during the pendency of a court or TTAB proceeding that is relevant to the issue of registrability of the involved mark, and so the USPTO proposes to eliminate the limitation in § 2.117 to other proceedings in which a party or parties are engaged.

Suspension normally will be maintained until the outcome of the proceeding has been finally determined. As set forth in the current version of the Trademark Trial and

Appeal Board Manual of Procedure § 510.02(b), the USPTO considers a proceeding to have been finally determined when an order or ruling that ends litigation has been rendered and noticed, and no appeal has been filed, or all appeals filed have been decided and the time for any further review has expired without further review being sought. The expiration of any further review includes the time for petitioning for rehearing or U.S. Supreme Court review. Thus, the Office normally will not lift a suspension until after the time for seeking such review has expired, a decision denying or granting such review has been rendered, and any further review has been completed.

VI. Attorney Recognition

The USPTO proposes revising § 2.17(g) to indicate that, for the purposes of an application or registration, recognition of a qualified attorney as the applicant's or registrant's representative will continue until the owner revokes the appointment or the attorney withdraws from representation. Thus, recognition would continue when, for example, an application abandons, post-registration documents are filed and accepted, or a registration expires or is cancelled. Accordingly, to end attorney recognition by the USPTO under the proposed rule, owners and attorneys would be required to proactively file an appropriate revocation or withdrawal document under § 2.19, rather than the current situation, where recognition automatically ends when one of the events listed in current § 2.17(g) occurs.

Under current § 2.17(g), once recognition has ended because of one of these events, either the previously recognized attorney or a newly appearing attorney may be recognized as the attorney of record by signing a submission to the USPTO on behalf of the applicant or registrant or by being named as the attorney in a submission filed on behalf of the applicant. *See* 37 CFR 2.17(b)(1)(ii), (iii). By contrast, under the proposed revision to § 2.17(g), if the applicant or registrant wishes to retain a new attorney for submissions to the USPTO following abandonment or registration, the applicant or

registrant would be required to revoke the original power of attorney, or the attorney would need to request to withdraw from representation, before a new attorney could be recognized.

The proposed revision to § 2.17(g) would also apply to attorney recognition when a change of ownership occurs. The USPTO does not require an assignment to be filed when a change of ownership occurs, and when an assignment is filed, the ownership information must be reviewed and manually entered into the relevant database fields. Therefore, the USPTO records may not reflect that an ownership change has occurred, and, in some cases, an ownership change does not result in a change in attorney representation. Accordingly, under the proposed rule, recognition of the attorney of record will continue, even when there is a change of ownership, until the attorney affirmatively withdraws or representation is revoked.

The USPTO is proposing this revision because current § 2.17(g) does not align with USPTO practice under § 2.18(a), which requires the USPTO to correspond with the applicant's or registrant's attorney if one is recognized. Section 2.18 states that the USPTO will correspond only with the applicant or registrant if the applicant or registrant is not represented by an attorney. Further, because recognition of representation ends at registration or abandonment under current § 2.17(g), the USPTO should cease recognition of the attorney and stop sending correspondence to the attorney's correspondence address. However, the USPTO's existing practice reflects that, in most cases, after an occurrence of an event listed in current § 2.17(g), representation continues and the attorney is the intended recipient of the trademark registration certificate, renewal reminders, and any other correspondence. For this reason, the USPTO continues to send correspondence to the attorney of record, except in connection with petitions to cancel filed with the TTAB, which are served on the registrant.

The USPTO's existing practice concerning attorney information is based on feedback from some stakeholders who expressed a preference for the USPTO to retain the information in the USPTO's database so that they would continue to receive correspondence without needing to be re-designated as attorney of record. In addition, despite the requirements of §§ 2.18(c) and 2.23(a), registrants do not always maintain up-to-date correspondence addresses. Therefore, they might not receive correspondence from the USPTO regarding post-registration actions, such as USPTO courtesy reminder notices to registrants regarding the time periods to file maintenance or renewal documents. Likewise, registrants who do not update their correspondence address might not receive notices of a petition to cancel filed with the TTAB. To help ensure receipt, in addition to emailing certain notices to the registrant's email address, the USPTO generally also emails them to the former attorney's email address.

Furthermore, the proposed revision is needed to facilitate implementation of a role-based access control system intended to improve USPTO database integrity. The USPTO recently required anyone filing applications or other documents to create a MyUSPTO.gov account to log in and access the filing and response forms in TEAS. This login requirement is intended to increase the security of the USPTO's electronic systems. In the near future, the USPTO plans to introduce identity verification requirements, assign roles to customer accounts (role-based access control), and restrict access to files to exclude actions by unauthorized parties. As part of the USPTO's forthcoming identity verification process, users are likely to be assigned a limited number of roles to control and delegate access to filings, including attorney, attorney support, owner, and public administrator roles. If the USPTO were to retain § 2.17(g) in its current form, while the last attorney of record could submit the TEAS form to file a maintenance document, the role-based access controls would require the attorney to first request IT permission from the owner to do so. This could result in missed deadlines.

Another consideration in revising this rule is the USPTO's continued efforts to track and combat misleading solicitations sent to trademark applicants and registrants. These misleading solicitations often offer unnecessary services to owners of trademark applications and registrations, and are created so as to deceive owners into believing the solicitations are official USPTO correspondence. Some of these solicitations offer services that are never provided, potentially putting a trademark application or registration at risk of abandonment, cancellation, or expiration. In other cases, these entities may engage in the unauthorized practice of law and file renewals and affidavits with bad specimens of use or improper signatures. These entities also frequently charge inflated fees for questionable and predominantly unnecessary services. Because an experienced trademark attorney may be in a better position than an unrepresented applicant or registrant to discern whether a particular item of correspondence is legitimate, the continuation of attorney recognition after abandonment or registration would allow attorneys of record to either intercept potentially fraudulent correspondence from reaching registrants or be alerted to solicitations their clients are receiving and counsel them appropriately.

Should the proposed revision to § 2.17(g) become effective, the USPTO plans to remove the name of any attorney whose recognition has already ended under existing § 2.17(g) from the current attorney-of-record field in the USPTO's database, along with the attorney's bar information and any docketing information. However, the attorney's correspondence information, including any correspondence email address, will be retained so that relevant correspondence and notices can continue to be sent to both the formerly recognized attorney and the owner. This will facilitate a period of transition to the new attorney recognition procedures while allowing the USPTO to proceed with its plans to implement updates to TEAS login processes. In accordance with § 2.17(b)(1), any attorney whose name is removed as attorney of record for this reason who wishes to

be re-recognized as attorney of record may do one of the following: (1) file an attorney appointment consistent with § 2.17(c); (2) sign a document on behalf of an unrepresented applicant, registrant, or party to a proceeding; or (3) appear by being identified as the attorney of record in a document submitted to the USPTO on behalf of an unrepresented applicant, registrant, or party to a proceeding.

The USPTO also proposes to add § 2.17(b)(4) to specify that, when a practitioner has been mistakenly, falsely, or fraudulently designated as an attorney for an applicant, registrant, or party to a proceeding without the practitioner's prior authorization or knowledge, recognition of that practitioner shall be ineffective.

In addition, the USPTO proposes to revise § 2.18(a)(1) to refer to "recognition" instead of "representation," consistent with the wording in § 2.18(a)(2). The term "recognition" reflects the fact that the USPTO does not control representation agreements between practitioners and clients but merely recognizes an attorney for purposes of representation before the USPTO. A revision is also proposed for § 2.18(a)(2) to indicate that, as with service of a cancellation petition, the USPTO may correspond directly with a registrant in connection with notices of institution of expungement or reexamination proceedings. Accordingly, the USPTO plans to send notices of institution of expungement and reexamination proceedings to the owner currently identified in the registration record and to the attorney of record, if any, or any previous attorney of record whose contact information is still in the record.

The USPTO also proposes revising § 2.19 to clarify practitioner obligations when withdrawing from representation and to specifically differentiate the grounds under which the attorney may request to withdraw versus those situations where an attorney must request withdrawal, consistent with the USPTO Rules of Professional Conduct. See 37 CFR 11.116.

Finally, the USPTO proposes amending § 2.61 to remove paragraph (c), which provides that, “[w]henver it shall be found that two or more parties whose interests are in conflict are represented by the same attorney, each party and also the attorney shall be notified of this fact.” This provision directly conflicts with § 2.18, and the attorney conduct addressed by this rule is encompassed and superseded by the USPTO Rules of Professional Conduct. See 37 CFR 11.107, 11.108.

VII. Court Orders Concerning Registrations

The USPTO also proposes the new § 2.177 to codify the USPTO’s longstanding procedures concerning action on court orders cancelling or affecting a registration under section 37, 15 U.S.C. 1119, that are currently set forth in § 1610 of the Trademark Manual of Examining Procedure. The USPTO requires submission of a certified copy of the order and normally does not act on such orders until the case is finally determined.

Discussion of Proposed Rule Changes

The USPTO proposes to add § 2.6(a)(26) to establish a fee of \$600, per class, for filing a petition for expungement and/or reexamination under § 2.91.

The USPTO proposes to add § 2.6(a)(27)(i) to establish a fee of \$225 for a request for an extension of time for filing a response to an Office action, under §§ 2.62(a)(2), 2.163(c), 2.165(c), 2.184(a)(2), or 2.186(c), on paper and § 2.6(a)(27)(ii) to establish a fee of \$125 for a request for an extension of time for filing a response to an Office action, under §§ 2.62(a)(2), 2.163(c), 2.165(c), 2.184(a)(2), or 2.186(c), via TEAS.

The USPTO proposes to amend § 2.11(d) to add cross-reference citations to §§ 2.93, 2.163, and 7.39, and to amend § 2.11(f) to add a cross-reference citation to § 2.93(c)(1).

The USPTO proposes to add § 2.17(b)(4) to specify that when a practitioner has been mistakenly, falsely, or fraudulently designated as a representative for an applicant,

registrant, or party to a proceeding without the practitioner's prior authorization or knowledge, recognition of that practitioner shall be ineffective.

The USPTO proposes to amend § 2.17(g) to indicate that, for the purposes of a pending application or registration, recognition of a power of attorney will continue until the applicant or registrant revokes it or the attorney withdraws from representation.

The USPTO proposes to amend § 2.18 to revise paragraph (a)(1) to clarify the circumstances when the Office will communicate directly with an applicant, registrant, or party to a proceeding and to revise paragraph (a)(2) to indicate that, with respect to notices of institution of expungement and reexamination proceedings, the Office may correspond directly with the applicant, registrant, or party to a proceeding.

The USPTO proposes to amend § 2.19 to revise paragraph (b) and add paragraphs (c) and (d) to better align this rule with attorney obligations under the USPTO Rules of Professional Conduct by clarifying practitioner obligations regarding withdrawing from representation and aligning the rules for permissive withdrawal with Office practice.

The USPTO proposes to amend § 2.23 to add paragraph (d)(3) to address the duty to monitor the status of a registration once an expungement or reexamination proceeding has been instituted.

The USPTO proposes to amend § 2.61 to remove paragraph (c).

The USPTO proposes to amend § 2.62 to revise paragraph (a) to provide for flexible response periods and extensions of time to respond and paragraph (c) to include a reference to requests for extensions of time to respond.

The USPTO proposes to amend § 2.63 to revise paragraph (b) to include a request for an extension of time to respond or appeal under § 2.62(a)(2) as a response option, and other minor stylistic changes; to revise paragraph (c) to include a reference to requests for extensions of time to respond or appeal under § 2.62(a)(2), and other minor stylistic changes; and to revise paragraph (d) to remove the wording "six-month."

The USPTO proposes to amend § 2.65 to revise paragraph (a) to replace “six months from the date of issuance” with “the relevant time period for response under § 2.62(a), including any granted extension of time to respond under § 2.62(a)(2).”

The USPTO proposes to amend § 2.66 to revise paragraph (b)(1) to replace the citation to § 2.6 with a citation to § 2.6(a)(15); revise paragraph (b)(3) by removing a portion to create new paragraph (b)(5); and add paragraph (b)(4) to include a provision for Office actions with a three-month response period.

The USPTO proposes to amend § 2.67 to codify the existing practice regarding suspension of proceedings before the USPTO and the TTAB.

The USPTO proposes to revise the undesignated center heading appearing before § 2.91 from “CONCURRENT USE PROCEEDINGS” to “EX PARTE EXPUNGEMENT AND REEXAMINATION.”

The USPTO proposes to add § 2.91 to set forth the procedures for petitions for expungement or reexamination.

The USPTO proposes to add § 2.92 to set forth the procedures for instituting ex parte expungement and reexamination proceedings.

The USPTO proposes to add § 2.93 to set forth the procedures for conducting expungement and reexamination proceedings.

The USPTO proposes to add § 2.94 to set forth the procedures for action after expungement or reexamination.

The USPTO proposes to add the undesignated center heading “CONCURRENT USE PROCEEDINGS” before existing § 2.99.

The USPTO proposes to revise the undesignated center heading appearing before § 2.111 from “CANCELLATION” to “CANCELLATION PROCEEDINGS BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD” to differentiate cancellation

proceedings before the TTAB from ex parte expungement and reexamination proceedings.

The USPTO proposes to amend § 2.111(b) to specify the time for filing a petition for cancellation with the TTAB on the ground specified in § 14(6) of the Act and to distinguish it from the timing of other nonuse claims.

The USPTO proposes to amend § 2.117(a) to include a reference to an expungement or reexamination proceeding instituted under § 2.92, to eliminate the limitation to other proceedings in which a party or parties are engaged, and to indicate that a civil action or proceeding is not considered to have been terminated until an order or ruling that ends litigation has been rendered and noticed and the time for any further review has expired with no further review sought.

The USPTO proposes to amend § 2.141 to revise the heading to “Ex parte appeals from refusal to register by action of trademark examining attorney”; revise paragraph (a) to replace the six-month deadline with a reference to the deadline and extension of time under proposed § 2.62(a); and revise paragraph (b) to remove the wording “six-month statutory” and to clarify that, if the applicant does not submit the required fee or specify the class(es) being appealed within the set time period, the TTAB will apply the fee(s) to the class(es) in ascending order, beginning with the lowest numbered class containing goods and/or services at issue in the appeal.

The USPTO proposes to amend § 2.142 to revise paragraph (a) to replace the six-month deadline with a reference to the deadline and extension of time under proposed § 2.62(a); revise paragraph (b)(3) to include reference to proceedings involving registrations; revise paragraph (d) for clarity and to create paragraphs (d)(1) and (d)(2) to address appeals from a refusal to register and appeals from an expungement or reexamination proceeding respectively; and add a subheading to paragraph (f) to clarify that this paragraph only applies to an appeal from a refusal to register.

The USPTO proposes to add § 2.143, which sets forth the procedures and requirements for ex parte appeals in expungement and reexamination proceedings.

The USPTO proposes to amend § 2.145 to revise paragraph (a)(1) to include a reference to ex parte expungement or reexamination proceedings and to revise paragraph (c)(1) to add an exception for ex parte expungement or reexamination proceedings.

The USPTO proposes to amend § 2.146 to include expungement and reexamination in paragraph (b); revise paragraph (c) to indicate that a petition requesting reinstatement of a registration cancelled in whole or in part for failure to timely respond to an Office action issued in an expungement and/or reexamination proceeding must include a response to the Office action, signed in accordance with § 2.193; and add paragraph (d)(2)(iv) to specify the filing deadline for a petition in connection with an expungement or reexamination proceeding.

The USPTO proposes to amend § 2.149 to revise paragraph (a) to replace the word “entry” with “inclusion” and amend paragraph (i) for clarity and to replace the words “not petitionable” with “final and non-reviewable and that a determination to include or not include evidence in the record shall not prejudice any party’s right to raise any issue and rely on any evidence in any other proceeding.”

The USPTO proposes to amend § 2.163 to revise paragraph (b) to specify a response deadline of three months; revise paragraph (c) to provide for extensions of time to respond; add paragraph (d) to address substantially complete responses; and add paragraph (e) to set forth the wording formerly in paragraph (c) with conforming revisions.

The USPTO proposes to amend § 2.165 to revise paragraph (a) to revise the internal citation to § 2.163(b)-(c); revise paragraph (b) to specify a response deadline of three months; revise paragraph (c) to provide for extensions of time to respond; add

paragraph (d) to specify that a registration will be cancelled if a response is not timely filed; and add paragraph (e) to set forth wording formerly in paragraph (c).

The USPTO proposes to add the undesignated center heading “COURT ORDERS UNDER SECTION 37” before § 2.177.

The USPTO proposes to add § 2.177 to address procedures concerning action on court orders cancelling or affecting a registration under section 37 of the Act.

The USPTO proposes to amend § 2.184 to revise paragraph (b)(1) to specify a response deadline of three months; revise paragraph (b)(2) to provide for extensions of time to respond; add paragraph (b)(3) to address substantially complete responses; add paragraph (b)(4) to set forth wording formerly in paragraph (b)(1); and add paragraph (b)(5) to set forth wording formerly in paragraph (b)(2).

The USPTO proposes to amend § 2.186 to revise paragraph (b) to specify a response deadline of three months; revise paragraph (c) to provide for extensions of time to respond; add paragraph (d) to specify that a registration will expire if a response is not timely filed; and add paragraph (e) to set forth wording formerly in paragraph (c).

The USPTO proposes to amend § 2.193(e)(5) to include a reference to petitions for expungement or reexamination.

The USPTO proposes to amend § 7.6 to add paragraph (a)(9)(i) to establish a fee of \$225 for a request for an extension of time for filing a response to an Office action under §§ 7.39(b) or 7.40(c) on paper and to add paragraph (a)(9)(ii) to establish a fee of \$125 for a request for an extension of time for filing a response to an Office action under §§ 7.39(b) or 7.40(c) via TEAS.

The USPTO proposes to amend § 7.39 to revise paragraph (a) to specify a response deadline of three months; revise paragraph (b) to provide for extensions of time to respond; revise paragraph (c) to address substantially complete responses; revise paragraph (d) to set forth wording formerly in paragraph (b); add paragraph (e) to set

forth wording formerly in paragraph (c); and add paragraph (f) to set forth wording formerly in paragraph (d).

The USPTO proposes to amend § 7.40 to revise paragraph (a) to revise the internal citation to § 7.39(b)-(c); revise paragraph (b) to specify a response deadline of three months; revise paragraph (c) to provide for extensions of time to respond; add paragraph (d) to specify that a registration will be cancelled if a response is not timely filed; and add paragraph (e) to set forth wording formerly in paragraph (c).

Rulemaking Requirements

A. Administrative Procedure Act: The changes proposed in this rulemaking involve rules of agency practice and procedure, and/or interpretive rules. See *Bachow Commc 'ns Inc. v. FCC*, 237 F.3d 683, 690 (D.C. Cir. 2001) (rules governing an application process are procedural under the Administrative Procedure Act); *Inova Alexandria Hosp. v. Shalala*, 244 F.3d 342, 350 (4th Cir. 2001) (rules for handling appeals are procedural where they do not change the substantive standard for reviewing claims); *Nat'l Org. of Veterans' Advocates v. Sec'y of Veterans Affairs*, 260 F.3d 1365, 1375 (Fed. Cir. 2001) (rule that clarifies interpretation of a statute is interpretive).

Accordingly, prior notice and opportunity for public comment for the changes proposed in this rulemaking are not required pursuant to 5 U.S.C. 553(b) or (c), or any other law. See *Cooper Techs. Co. v. Dudas*, 536 F.3d 1330, 1336-37 (Fed. Cir. 2008) (stating that 5 U.S.C. 553, and thus 35 U.S.C. 2(b)(2)(B), do not require notice and comment rulemaking for “interpretative rules, general statements of policy, or rules of agency organization, procedure, or practice” (quoting 5 U.S.C. 553(b)(A))). However, the USPTO has chosen to seek public comment before implementing the rule to benefit from the public’s input.

B. Regulatory Flexibility Act: The USPTO publishes this Initial Regulatory Flexibility Analysis (IRFA), as required by the Regulatory Flexibility Act (RFA) (5 U.S.C. 601 et

seq.), to examine the impact of the Office's proposed changes to trademark fees on small entities and to seek the public's views. Under the RFA, whenever an agency is required by 5 U.S.C. 553 (or any other law) to publish a notice of proposed rulemaking (NPRM), the agency must prepare and make available for public comment an IRFA, unless the agency certifies under 5 U.S.C. 605(b) that the proposed rule, if implemented, will not have a significant economic impact on a substantial number of small entities. 5 U.S.C. 603, 605.

Items 1-5 below discuss the five items specified in 5 U.S.C. 603(b)(1)-(5) to be addressed in an IRFA. Item 6 below discusses alternatives to this proposal that the Office considered. The USPTO invites public comments on these items.

1. Description of the reasons that action by the USPTO is being considered:

The USPTO proposes to amend the rules of practice in trademark cases to implement provisions of the Trademark Modernization Act of 2020, Pub. L. No. 116-260, Div. Q, Tit. II, Subtit. B, § 228 (Dec. 27, 2020). The TMA sets a deadline of December 27, 2021, for the USPTO to promulgate rules governing letter-of-protest procedures and implementing ex parte expungement and reexamination proceedings for cancellation of a registration when the required use in commerce of the registered mark has not been made. In addition, the TMA authorizes the USPTO to promulgate rules to provide for flexible Office action response periods. The USPTO also proposes to set fees for petitions requesting institution of ex parte expungement and reexamination proceedings and for requests to extend Office action response deadlines, as required or authorized by the TMA, and to amend the rules concerning the suspension of USPTO proceedings and the rules governing attorney recognition in trademark matters.

2. Succinct statement of the objectives of, and legal basis for, the proposed rule:

As required or authorized by the TMA, the objective of the proposed rule is to implement the provisions of the TMA by: (1) establishing ex parte expungement and

reexamination proceedings for cancellation of a registration when the required use in commerce of the registered mark has not been made, to ensure an accurate trademark register that supports and promotes commerce; (2) amending the rules governing the USPTO's letter-of-protest procedures, which allow third parties to submit evidence to the USPTO regarding a trademark's registrability during the initial examination of the trademark application, to provide that the decision whether to include such evidence in the application record is final and non-reviewable and that such a determination shall not prejudice any party's right to raise any issue and rely on any evidence in any other proceeding; and (3) implementing flexible response periods, along with optional extensions of time, to promote efficiency in examination by shortening the prosecution timeline for applications with issues that are relatively simple to address, while providing sufficient time for response to Office actions with more complex issues. In addition, this proposed rule is also intended to formalize existing practice regarding suspension of proceedings before the Office and the TTAB; to align the rules on attorney recognition with current USPTO practice, facilitate implementation of a role-based access control system intended to improve USPTO database integrity, and ensure trademark correspondence is sent to the appropriate party; and to add a new rule to address procedures regarding court orders cancelling or affecting registrations. Finally, the proposed rule establishes fees for the ex parte expungement and reexamination proceedings and for extensions of time to respond to an Office action.

3. Description of and, where feasible, estimate of the number of affected small entities:

The USPTO does not collect or maintain statistics in trademark cases on small-versus large-entity applicants, and this information would be required in order to determine the number of small entities that would be affected by the proposed rule. The proposed rule would apply to all persons who are filing a response to an Office action,

are represented by an attorney, are seeking to submit a petition requesting institution of an expungement or reexamination proceeding, or are providing a response in such a proceeding.

The proposed rule includes provisions for flexible response periods to respond to Office actions. Under this proposed rule, all filers would have an option to file a no-cost response if they do so within three months of the Office action's issue date. The proposed changes would benefit all trademark owners by encouraging faster prosecution of applications, and USPTO believes this three-month response period is reasonable for all applicants, including small entities, given the efficiencies of current practices utilizing email and electronic filing and notification of all documents.

The proposed changes to the rule regarding attorney recognition benefit all parties, including small entities, by conforming USPTO rules with current practices, facilitating implementation of a role-based access control system intended to improve USPTO database integrity, and aiding the USPTO's continued efforts to track and combat misleading solicitations sent to trademark applicants and registrants.

Lastly, the proposed provisions governing the ex parte expungement and reexamination proceedings created under the TMA will benefit all parties, including small entities, by helping to ensure the accuracy of the USPTO's trademark register by cancelling registrations, in whole or in part, for which the required use of the registered mark in commerce has not been made. Moreover, these proceedings will provide a faster, more efficient, and less costly alternative to proceedings before the TTAB or civil litigation in the courts. This should decrease or eliminate the potential costs that otherwise would have been incurred to litigate in proceedings to cancel a registration or resolve a dispute over a mark, or to change business plans to avoid the use of a chosen mark when the required use has not been made.

4. Description of the reporting, recordkeeping, and other compliance requirements of the proposed rule, including an estimate of the classes of small entities which will be subject to the requirement and the type of professional skills necessary for preparation of the report or record:

The proposed rule will require creation of new online forms to submit a request to institute an expungement or reexamination proceeding, to respond to Office actions issued during such proceedings, and to request extensions of time to respond to Office actions, as further described in the preamble of this proposed rule.

The USPTO does not anticipate the proposed rule to have a disproportionate impact upon any particular class of small or large entities. Any entity that has a pending trademark application or a registered trademark could potentially be impacted by this proposed rule.

The professional skills necessary for completion of the online forms are not more burdensome than the skills necessary for completion of current USPTO reporting requirements and would not be disproportionately burdensome for small entities.

5. Identification, to the extent practicable, of all relevant Federal rules which may duplicate, overlap, or conflict with the proposed rule:

The proposed rule would not duplicate, overlap, or conflict with any other Federal rules.

6. Description of any significant alternatives to the proposed rule which accomplish the stated objectives of applicable statutes and which minimize any significant economic impact of the rule on small entities:

The TMA mandates the framework for many of the procedures proposed in this rulemaking, particularly in regard to the changes to the letter of protest procedures and most of the procedures for the new ex parte expungement and reexamination proceedings, except for those indicated below. Thus, the USPTO has little to no

discretion in the rulemaking required to implement those procedures. Accordingly, the discussion below addresses only those provisions for which alternatives were possible because the TMA provided the Director discretion to implement regulations. In those cases, the USPTO chose the option that best balanced the need to achieve the stated objectives with the need to create processes that are the least burdensome on all parties.

Fees: As authorized by the TMA, the proposed rule establishes fees for petitions requesting ex parte expungement or reexamination of a registration and for extensions of time to respond to an Office action. The USPTO proposes a fee of \$600 per class for a petition requesting ex parte expungement or reexamination of a registration, with the intent to balance the need for cost recovery with the objective of providing a lower-cost alternative for third parties to seek cancellation of registered marks for which the required use in commerce has not been made. The USPTO considered alternative fee proposals for these newly created ex parte proceedings. One option was to charge \$250 per petition, which is the same amount as the current fee for electronically filed petitions to the Director under § 2.146. However, that amount was determined to be insufficient for cost recovery because petitions for expungement or reexamination are different proceedings than other petitions to the Director, because reviewing these petitions and conducting any resulting proceeding will require more time and resources. Therefore they are likely to incur higher processing costs. In addition, the USPTO considered setting the fee at \$1,000 per class of goods or services involved in the petition. However, this amount was deemed too high in view of the USPTO's objective to provide an inexpensive mechanism for cancellation of a registration when the required use in commerce of the registered mark has not been made.

The USPTO is also proposing a fee of \$125 for electronically filed extensions of time to respond to an Office action and a fee of \$225 for such extensions that are filed on paper. These fees are consistent with the current fees for requesting an extension of time

to file a statement of use and are intended to recover associated costs while incentivizing applicants to respond to Office actions within the initial three-month deadline. The USPTO considered the alternative to charge no fee for such extensions, but that option would not aid in cost recovery and would not provide an incentive to respond earlier, undermining the purpose of the proposed flexible response periods.

Limit on petitions requesting expungement or reexamination: The USPTO is not currently proposing a limitation on the number of petitions for expungement or reexamination that can be filed against a registration. However, the Office did consider such a limit of petition-initiated proceedings against a registration that had already been the subject of instituted proceedings in order to provide a definite end to challenges, leaving any further challenges to TTAB cancellation proceedings. Considering that there are already safeguards in place to prevent abuse, the Office was concerned that imposing artificial limitations might undermine the utility of the proceedings to clear the register of unused marks. In addition, the USPTO considered the alternatives of limiting the number of petitions a particular petitioner or real party in interest may file, but those options did not further the ultimate purpose of the expungement or reexamination proceeding, which is to cancel a registration in whole or in part when evidence shows that use of the mark in commerce has not been made.

Reasonable investigation and evidence: Under the TMA and the proposed rule, a petition for expungement or reexamination must include a verified statement that sets forth the elements of the reasonable investigation the petitioner conducted to determine that the mark was never used in commerce (for expungement petitions) or not in use in commerce as of the relevant date (for reexamination petitions) on or in connection with the goods and/or services identified in the petition. The proposed rule defines a “reasonable investigation” as one that is based on available information and must include searches calculated to return information about the underlying inquiry from reasonably

accessible sources where evidence concerning use of the mark during the relevant time period on or in connection with the relevant goods and/or services would normally be found. The proposed rule indicates that a sufficient reasonable investigation will depend on the individual circumstances, but includes a non-exhaustive list of sources of evidence for a reasonable investigation. These include State and Federal trademark records, internet websites, records from State and Federal agencies, litigation records, knowledge of marketplace activities, and any other reasonably accessible source with information relevant to whether the mark at issue was used in commerce.

The USPTO considered an alternative approach of providing a more exhaustive list of the types of evidence that would meet the burden for these newly created proceedings. However, the USPTO acknowledges that the types of evidence will vary by industry and the types of goods and services being challenged. Therefore, it is not practical to create a complete list in the rule that would apply in all situations. Instead, the USPTO opted to identify a standard in line with the statute and legislative history, and to include a non-exhaustive list of efforts and evidence to meet the standard. This alternative provides guidance to filers while not limiting them to specific types of evidence listed in the rule.

Director-initiated proceedings: The TMA authorizes Director-initiated expungement and reexamination proceedings. In addition to the requirements in the TMA, the proposed rule explains that the Director may institute a proceeding that includes additional goods and/or services identified in the subject registration on the Director's own initiative and consolidate consideration of the new proceeding with the pending proceeding. The USPTO considered an alternative approach that involved not allowing consolidation of proceedings in this circumstance, but this option would hinder proper and efficient management of multiple related proceedings.

Response time periods in new ex parte proceedings: The proposed rule sets a deadline of two months for responding to a non-final or final Office action issued in a reexamination and/or expungement proceeding. The USPTO considered a number of alternatives to this response deadline framework. These alternatives included a two-month response period with an optional one-month extension; a three-month response period for the initial Office action and a three-month period for the final Office action; and different response periods for the initial Office action and the final Office action.

In weighing these options, the Office considered the fact that, once an Office action has been received by a registrant, the registrant will need time to review the content of the Office action, hire counsel if needed, and conduct fact-finding and evidence gathering in order to provide a response. The Office also considered the fact that a traditional six-month response period maximizes the time for the registrant to engage in these necessary activities but could potentially result in prolonged review, which is contrary to the objective to provide a faster and more efficient alternative to addressing claims of lack of proper use.

The selected two-month response period balances this objective with the registrant's need for time to engage in the necessary activities to provide a response to the Office action. Furthermore, the USPTO plans to provide a courtesy notification to the registrant that a petition has been filed so as to facilitate early notice of a possible proceeding.

Flexible response periods: The TMA authorizes the USPTO to establish flexible response periods to respond to Office actions. The proposed rule sets a period of three months for responding to an Office action in applications under sections 1 and/or 44 of the Act, but provides an option for applicants to request a single three-month extension of this three-month deadline, for a total response time of up to six months. The same response deadline framework is also proposed for post-registration Office actions issued

in connection with the examination of registration maintenance documents. This proposed alternative was selected because it is supported by the USPTO's data analytics regarding average response times, is the option with the least burden and costs for filers, and avoids uncertainty in filing deadlines by providing consistent deadlines for responses.

The USPTO considered three alternatives to the proposals to implement flexible response periods. The first alternative was to maintain six-month response periods for any Office action that contains a substantive refusal and provide a shorter response period for any Office action that contained only formal requirements, because responses for these typically require less time. This alternative may require some discretion by examining attorneys to decide which response period applies if, for example, it is not clear whether the Office action contains a substantive refusal. Additionally, public feedback indicated that this approach results in the length of the response period being unknown until the Office action is received and would require the monitoring of multiple possible deadlines.

A second alternative considered was to offer shorter response periods for all Office actions, but to offer an initial response period of two months, with one-month extensions with a corresponding fee, to reach the full six months. The fee for extension would be progressively higher, depending on when the response and extension request were filed. For example, responses filed in the third, fourth, fifth, or sixth month would, respectively, have an extension fee of \$50, \$75, \$125, and \$150. An application would be abandoned when a response is not received within the two-month period or such other extended deadline as requested and paid for by applicant, not to exceed six months from the Office action issue date. This alternative puts a greater burden on filers to track multiple deadlines and could also increase costs to filers to file and pay for multiple extensions to reach the full six-month period for response.

Finally, the USPTO considered a two-phase examination system. Under this approach, a USPTO examiner could review application formalities and issue a formalities Office action with a shortened response period of two months, extendable in two-month increments to a full six months upon request and payment of a fee. Once the formalities were addressed, the application could enter the second phase of the examination, whereby an examiner would issue an Office action containing any substantive refusals that identifies a response deadline of three months, extendable for another three months to a total of six months, upon request and payment of a fee.

Suspension of proceedings: The USPTO proposes amendments to the rules concerning suspension of proceedings to align them with current practice and to clarify that the new ex parte expungement and reexamination proceedings are among the types of proceedings for which suspension of action by the Office or the TTAB is authorized.

The alternative was to take no action in amending these rules, but that option would result in a continued misalignment of the rules and USPTO practice, and could hinder proper and efficient management of multiple related proceedings.

Attorney recognition: The proposed rule provides that, for the purposes of an application or registration, recognition of a qualified attorney as the applicant's or registrant's representative will continue until the owner revokes the appointment or the attorney withdraws from representation. This would allow recognition to continue when an application abandons, post-registration documents are filed, or a registration expires or is cancelled. Accordingly, owners and attorneys would be required to proactively file documents to, respectively, revoke an appointment or withdraw from representation when the representation has ended, rather than simply having recognition by the USPTO end automatically when certain events, including abandonment or registration, occur. In addition, the proposed rule provides that, when a practitioner has been mistakenly, falsely, or fraudulently designated as a representative for an applicant, registrant, or party

to a proceeding without the practitioner's prior authorization or knowledge, recognition of that practitioner shall be ineffective. It also clarifies practitioners' obligations when withdrawing from representation and proposes to delete a provision relating to conflicts of interest that has been superseded by the USPTO's Rules of Professional Conduct.

The USPTO considered not updating the current rules on attorney recognition as an alternative to the proposed rule. However, leaving the regulations as they are currently written would result in continued inconsistency between the rule and current USPTO practice, would complicate the implementation a role-based access control system that is intended to improve USPTO database integrity, and would potentially hinder the USPTO's ability to combat misleading solicitations sent to trademark applicants and registrants as well as other improper activities.

C. Executive Order 12866 (Regulatory Planning and Review): This rule has been determined to be Significant for purposes of Executive Order 12866 (Sept. 30, 1993).

D. Executive Order 13563 (Improving Regulation and Regulatory Review): The USPTO has complied with Executive Order 13563 (Jan. 18, 2011). Specifically, the USPTO has, to the extent feasible and applicable: (1) made a reasoned determination that the benefits justify the costs of the rule; (2) tailored the rule to impose the least burden on society consistent with obtaining the regulatory objectives; (3) selected a regulatory approach that maximizes net benefits; (4) specified performance objectives; (5) identified and assessed available alternatives; (6) provided the public with a meaningful opportunity to participate in the regulatory process, including soliciting the views of those likely affected prior to issuing an NPRM, and provided online access to the rulemaking docket; (7) attempted to promote coordination, simplification, and harmonization across government agencies and identified goals designed to promote innovation; (8) considered approaches that reduce burdens and maintain flexibility and freedom of choice for the

public; and (9) ensured the objectivity of scientific and technological information and processes, to the extent applicable.

E. Executive Order 13132 (Federalism): This rulemaking does not contain policies with federalism implications sufficient to warrant preparation of a Federalism Assessment under Executive Order 13132 (Aug. 4, 1999).

F. Executive Order 13175 (Tribal Consultation): This rulemaking will not: (1) have substantial direct effects on one or more Indian tribes, (2) impose substantial direct compliance costs on Indian tribal governments, or (3) preempt tribal law. Therefore, a tribal summary impact statement is not required under Executive Order 13175 (Nov. 6, 2000).

G. Executive Order 13211 (Energy Effects): This rulemaking is not a significant energy action under Executive Order 13211 because this rulemaking is not likely to have a significant adverse effect on the supply, distribution, or use of energy. Therefore, a Statement of Energy Effects is not required under Executive Order 13211 (May 18, 2001).

H. Executive Order 12988 (Civil Justice Reform): This rulemaking meets applicable standards to minimize litigation, eliminate ambiguity, and reduce burden as set forth in sections 3(a) and 3(b)(2) of Executive Order 12988 (Feb. 5, 1996).

I. Executive Order 13045 (Protection of Children): This rulemaking does not concern an environmental risk to health or safety that may disproportionately affect children under Executive Order 13045 (Apr. 21, 1997).

J. Executive Order 12630 (Taking of Private Property): This rulemaking will not affect a taking of private property or otherwise have taking implications under Executive Order 12630 (Mar. 15, 1988).

K. Congressional Review Act: Under the Congressional Review Act provisions of the Small Business Regulatory Enforcement Fairness Act of 1996 (5 U.S.C. 801 et seq.),

prior to issuing any final rule, the USPTO will submit a report containing the final rule and other required information to the United States Senate, the United States House of Representatives, and the Comptroller General of the Government Accountability Office. The changes in this proposed rule are not expected to result in an annual effect on the economy of \$100 million or more, a major increase in costs or prices, or significant adverse effects on competition, employment, investment, productivity, innovation, or the ability of United States-based enterprises to compete with foreign-based enterprises in domestic and export markets. Therefore, this proposed rule is not expected to result in a “major rule” as defined in 5 U.S.C. 804(2).

L. Unfunded Mandates Reform Act of 1995: The changes set forth in this rulemaking do not involve a Federal intergovernmental mandate that will result in the expenditure by State, local, and tribal governments, in the aggregate, of \$100 million (as adjusted) or more in any one year, or a Federal private sector mandate that will result in the expenditure by the private sector of \$100 million (as adjusted) or more in any one year, and will not significantly or uniquely affect small governments. Therefore, no actions are necessary under the provisions of the Unfunded Mandates Reform Act of 1995. See 2 U.S.C. 1501 et seq.

M. National Environmental Policy Act of 1969: This rulemaking will not have any effect on the quality of the environment and is thus categorically excluded from review under the National Environmental Policy Act of 1969. See 42 U.S.C. 4321 et seq.

N. National Technology Transfer and Advancement Act of 1995: The requirements of section 12(d) of the National Technology Transfer and Advancement Act of 1995 (15 U.S.C. 272 note) are not applicable because this rulemaking does not contain provisions that involve the use of technical standards.

O. Paperwork Reduction Act of 1995: In accordance with section 3507(d) of the Paperwork Reduction Act of 1995 (44 U.S.C. 3501 et seq.), some of the paperwork and

other information collection burdens discussed in this proposed rulemaking have already been approved under Office of Management and Budget (OMB) Control Numbers 0651-0040 (Trademark Trial and Appeal Board (TTAB) Actions), 0651-0050 (Response to Office Action and Voluntary Amendment Forms), and 0651-0055 (Post Registration (Trademark Processing)).

In addition, this proposed rulemaking adds new items and fees regarding petitions requesting institution of expungement and reexamination proceedings, responses to Office actions issued in connection with expungement and reexamination, and requests for an extension of time to respond to an Office action. The new information collection requirements included in this proposed rulemaking have been submitted as a new information collection request (ICR) for approval to OMB.

Please send comments on this new ICR to OMB's Office of Information and Regulatory Affairs via email to oir-submissions@omb.eop.gov, Attention: Desk Officer for USPTO, Washington, DC 20503. Please state that your comments refer to Docket No. PTO-T-2021-0008. Please send a copy of your comments to USPTO using one of the methods described under ADDRESSES at the beginning of this document.

Title of information collection: Expungement and Reexamination Proceedings.

Affected public: Private sector, individuals, and households.

Estimated annual number of respondents: 10,561.

Estimated annual number of responses: 11,116.

Estimated total annual burden hours: 10,865.

Estimated total annual respondent hourly cost burden: \$4,346,000.

Table 1: Proposed Burden Hours for Private Sector Respondents

Item No.	Item	Estimated Annual Respondents	Estimated Annual Responses (year)	Estimated Time for Response (hour)	Estimated Annual Burden (hour/year)	Rate ¹ (\$/hour)	Estimated Annual Burden
			(a)	(b)	(a) x (b) = (c)	(d)	(c) x (d) =(e)
1	Petition for Ex Parte Expungement	1,843	1,940	1.5	2,910	\$400	\$1,164,000
2	Response to Ex Parte Expungement Office Action	1,659	1,746	1	1,746	\$400	\$698,400
3	Response to Director-Initiated Expungement Office Action	185	194	1	194	\$400	\$77,600
4	Petition for Ex Parte Reexamination	1,229	1,294	1.5	1941	\$400	\$776,400
5	Response to Ex Parte Reexamination Office Action	1,106	1,164	1	1,164	\$400	\$465,600
6	Response to Ex Parte Director-Initiated Reexamination Office Action	123	130	1	130	\$400	\$52,000
7	Request for Extension of Time for Filing a Response to Office Action	2,304	2,425	0.25	606	\$400	\$242,400
	Totals	8,449	8,893		8,691		\$3,476,400

Table 2: Proposed Burden Hours for Individual and Household Respondents

Item No.	Item	Estimated Annual Respondents	Estimated Annual Responses (year)	Estimated Time for Response (hour)	Estimated Annual Burden (hour/year)	Rate ² (\$/hour)	Estimated Annual Burden
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¹ 2019 Report of the Economic Survey, published by the Committee on Economics of Legal Practice of the American Intellectual Property Law Association (AIPLA), <https://www.aipla.org/detail/journal-issue/2019-report-of-the-economic-survey>. The USPTO uses the mean rate for attorneys in private firms, which is \$400 per hour.

² 2019 Report of the Economic Survey, published by the Committee on Economics of Legal Practice of the American Intellectual Property Law Association (AIPLA), <https://www.aipla.org/detail/journal-issue/2019-report-of-the-economic-survey>. The USPTO uses the mean rate for attorneys in private firms, which is \$400 per hour.

			(a)	(b)	(a) x (b) = (c)	(d)	(c) x (d) = (e)
1	Petition for Ex Parte Expungement	461	485	1.5	728	\$400	\$291,200
2	Response to Ex Parte Expungement Office Action	415	437	1	437	\$400	\$174,800
3	Response to Director-Initiated Expungement Office Action	46	49	1	49	\$400	\$19,600
4	Petition for Ex Parte Reexamination	307	323	1.5	485	\$400	\$194,000
5	Response to Ex Parte Reexamination Office Action	276	291	1	291	\$400	\$116,400
6	Response to Ex Parte Director-Initiated Reexamination Office Action	31	32	1	32	\$400	\$12,800
7	Request for Extension of Time for Filing a Response to Office Action	576	606	0.25	152	\$400	\$60,800
	Totals	2,112	2,223		2,174		\$869,600

Estimated total annual respondent non-hourly cost burden: \$2,810,175.

This information collection has non-hourly cost burden in fees paid by the respondents. There are filing fees associated with this information collection for a total of \$2,810,175 per year as outlined in Table 3 below. The filing fees for petitions for expungement or reexamination are based on the number of classes of goods and/or services in the petition; therefore, the total filing fees for these submissions can vary depending on the number of classes. The filing fees shown here are the minimum fees associated with this information collection.

Table 3: Filing Fees/Non-hourly Cost Burden to Respondents

Item No.	Item	Estimated Annual Responses	Filing Fees (\$)	Total Cost (\$)
		(a)	(b)	(a) x (b) = (c)
1	Petition for Ex Parte Expungement	2,425	\$600	\$1,455,000
4	Petition for Ex Parte Reexamination	1,617	\$600	\$970,200
7	Request for Extension of Time for Filing a Response to Office Action (paper)	61	\$225	\$13,725
8	Request for Extension of Time for Filing a Response to Office Action (TEAS)	2,970	\$125	\$371,250
	Totals	7,073		\$2,810,175

The USPTO is soliciting public comments on this new ICR to:

- (a) Evaluate whether the proposed collection of information is necessary for the proper performance of the functions of the Agency, including whether the information will have practical utility;
- (b) Evaluate the accuracy of the Agency's estimate of the burden of the proposed collection of information, including the validity of the methodology and assumptions used;
- (c) Enhance the quality, utility, and clarity of the information to be collected; and
- (d) Minimize the burden of the collection of information on those who are to respond, including through the use of appropriate automated, electronic, mechanical, or other technological collection techniques or other forms of IT, e.g., permitting electronic submission of responses.

Please submit comments on this new collection of information at

www.reginfo.gov/public/do/PRAMain. Find this particular information collection by selecting "Currently under Review" or by using the search function and entering the title of the collection. Please send a copy of your comments to the USPTO using one of the methods described under "ADDRESSES" at the beginning of this document.

All comments submitted in response to this proposed rulemaking are a matter of public record. The USPTO will respond to any ICR-related comments in the final rulemaking. Copies of this information collection may be viewed at the Federal eRulemaking Portal (www.regulations.gov) or can be requested from the USPTO via email at Information.Collection@uspto.gov.

Notwithstanding any other provision of law, no person is required to respond to, nor shall any person be subject to, a penalty for failure to comply with a collection of information subject to the requirements of the Paperwork Reduction Act unless that collection of information has a valid OMB control number.

P. E-Government Act Compliance: The USPTO is committed to compliance with the E-Government Act to promote the use of the internet and other information technologies to provide increased opportunities for citizen access to Government information and services, and for other purposes. For information pertinent to E-Government Act compliance related to this proposed rule, please contact Kimberly Hardy, USPTO Information Collection Officer, via email at Information.Collection@uspto.gov or via telephone at 571-270-0968.

List of Subjects

37 CFR Part 2

Administrative practice and procedure, Courts, Lawyers, Trademarks.

37 CFR Part 7

Administrative practice and procedure, Trademarks.

For the reasons stated in the preamble and under the authority contained in 15 U.S.C. 1123 and 35 U.S.C. 2, as amended, the USPTO proposes to amend parts 2 and 7 of title 37 as follows:

PART 2 - RULES OF PRACTICE IN TRADEMARK CASES

1. The authority citation for 37 CFR part 2 is revised to read as follows:

Authority: 15 U.S.C. 1113, 1123; 35 U.S.C. 2; Section 10, Pub. L. 112-29; Pub. L. 116-260, 134 Stat. 1182, unless otherwise noted. Sec. 2.99 also issued under secs. 16, 17, 60 Stat. 434; 15 U.S.C. 1066, 1067.

2. Amend § 2.6 by adding paragraphs (a)(26) and (27) to read as follows:

§ 2.6 Trademark fees.

(a) * * *

(26) *Petition for expungement and/or reexamination.* For filing a petition for expungement and/or reexamination under § 2.91, per class—\$600.00

(27) *Extension of time for filing a response to an Office action under §§ 2.62(a)(2), 2.141(a), 2.163(c), 2.165(c), 2.184(b)(2) or 2.186(c).*

(i) For filing a request for extension of time for filing a response to an Office action under §§ 2.62(a)(2), 2.141(a), 2.163(c), 2.165(c), 2.184(b)(2) or 2.186(c) on paper—\$225.00

(ii) For filing a request for extension of time for filing a response to an Office action under §§ 2.62(a)(2), 2.141(a), 2.163(c), 2.165(c), 2.184(b)(2) or 2.186(c) via TEAS—\$125.00

3. Amend § 2.11 by revising paragraphs (d) and (f) to read as follows:

§ 2.11 Requirement for representation.

* * * * *

(d) Failure to respond to requirements issued pursuant to paragraphs (a) through (c) of this section is governed by §§ 2.65, 2.93, 2.163, and 7.39, as appropriate.

* * * * *

(f) Notwithstanding §§ 2.63(b)(2)(ii) and 2.93(c)(1), if an Office action maintains only requirements under paragraphs (a), (b), and/or (c) of this section, or only requirements under paragraphs (a), (b), and/or (c) of this section and the

requirement for a processing fee under § 2.22(c), the requirements may be reviewed only by filing a petition to the Director under § 2.146.

4. Amend § 2.17 by:

a. Adding a new paragraph (b)(4), and

b. Revising paragraph (g).

The addition and revision read as follows:

§ 2.17 Recognition for representation.

* * * * *

(b) * * *

(4) *False, fraudulent, or mistaken designation.* Regardless of paragraph (b)(1) of this section, where a practitioner has been mistakenly, falsely, or fraudulently designated as a representative for an applicant, registrant, or party to a proceeding without the practitioner's prior authorization or knowledge, recognition of that practitioner shall be ineffective.

* * * * *

(g) *Duration of recognition.* The USPTO considers recognition as to an application or registration to continue until the applicant, registrant, or party to a proceeding revokes authority pursuant to § 2.19(a)(1) or the representative withdraws from representation under § 2.19(b).

5. Amend § 2.18 by revising paragraphs (a)(1) and (2) to read as follows:

§ 2.18 Correspondence, with whom held.

(a) * * *

(1) If an attorney is not recognized as a representative pursuant to § 2.17(b)(1), the Office will send correspondence to the applicant, registrant, or party to the proceeding.

(2) If an attorney is recognized as a representative pursuant to § 2.17(b)(1), the Office will correspond only with that attorney, except as set forth below. A

request to change the correspondence address does not revoke a power of attorney. The Office will not correspond with another attorney from a different firm and, except for service of a cancellation petition and notices of institution of expungement or reexamination proceedings, will not correspond directly with the applicant, registrant, or a party to a proceeding, unless:

- (i) Recognition of the attorney has ended pursuant to § 2.19; or
- (ii) The attorney has been suspended or excluded from practicing in trademark matters before the USPTO.

* * * * *

6. Amend § 2.19 by:

- a. Revising paragraph (b), and
- b. Adding paragraphs (c) and (d).

The revision and addition read as follows:

§ 2.19 Revocation or withdrawal of attorney.

* * * * *

(b) *Withdrawal of attorney required.* If the requirements of § 11.116(a) of this chapter are met, a practitioner authorized to represent an applicant, registrant, or party to a proceeding in a trademark case must withdraw from representation before the USPTO by filing a request to withdraw or, when applicable, a motion with the Trademark Trial and Appeal Board as soon as practicable, but no longer than 30 days after the condition necessitating withdrawal unless the applicant, registrant, or party to a proceeding has already revoked the practitioner's authority pursuant to paragraph (a) of this section. The request or motion to withdraw must include the following:

- (1) The application serial number, registration number, or proceeding number;
- (2) A statement of the reason(s) why withdrawal is required under the rules; and

(3) A statement that the practitioner shall take steps reasonably practicable under the circumstances to protect the client's interests.

(c) *Withdrawal of attorney permitted.* A practitioner may withdraw from representation before the USPTO if the requirements of § 11.116(b) of this chapter are met, upon application to and approval by the Director or, when applicable, upon motion granted by the Trademark Trial and Appeal Board. The practitioner must file the request to withdraw as soon as practicable, but no longer than 30 days after the practitioner notifies the client of the termination of representation unless the applicant, registrant, or party to a proceeding has already revoked the practitioner's authority pursuant to paragraph (a) of this section. The request to withdraw must include the following:

(1) The application serial number, registration number, or proceeding number;

(2) A statement of the reason(s) for the request to withdraw; and

(3) Either:

(i) A statement that the practitioner has given notice to the client that the practitioner is withdrawing from employment and will be filing the necessary documents with the Office; that the client was given notice of the withdrawal at least two months before the expiration of any applicable deadline; that the practitioner has delivered to the client all documents and property in the practitioner's file to which the client is entitled; and that the practitioner has notified the client of any pending or upcoming submission deadlines; or

(ii) If more than one qualified practitioner is of record, a statement that representation by another currently recognized attorney is ongoing.

(d) *Recognition ineffective.* If recognition is not effective under § 2.17(b)(4), then revocation under paragraph (a) of this section or withdrawal under paragraph (b) or (c) of this section is not required.

7. Amend § 2.23 by adding paragraph (d)(3), to read as follows:

§ 2.23 Requirement to correspond electronically with the Office and duty to monitor status.

* * * * *

(d) * * *

(3) After notice of the institution of an expungement or reexamination proceeding under § 2.92, at least every two months until the registrant receives a notice of termination under § 2.94, or, if no notice of institution was received, at least every six months following the issue date of the registration.

§ 2.61 [Amended]

8. Amend § 2.61 by removing paragraph (c).

9. Amend § 2.62 by revising paragraphs (a) and (c) to read as follows:

§ 2.62 Procedure for submitting response.

(a) *Deadline.* Each Office action shall set forth the deadline for response.

(1) *Response periods.* Unless the applicant is notified otherwise in an Office action, the response periods for an Office action are as follows:

(i) Three months from the issue date, for an Office action in an application under section 1 and/or section 44 of the Act; and

(ii) Six months from the issue date, for an Office action in an application under section 66(a) of the Act.

(2) *Extensions of time.* Unless the applicant is notified otherwise in an Office action, the time for response designated in paragraph (a)(1)(i) of this section may be extended by three months up to a maximum of six months from the Office action issue date, upon timely request and payment of the fee set forth in

§ 2.6(a)(27). To be considered timely, a request for extension of time must be received by the Office on or before the deadline for response set forth in the Office action.

* * * * *

(c) *Form*. Responses and requests for extensions of time to respond must be submitted through TEAS pursuant to § 2.23. Responses and requests for extensions of time to respond sent via email or facsimile will not be accorded a date of receipt.

10. Amend § 2.63 by revising paragraphs (b) introductory text, (b)(1) and (2), and (c) and (d) to read as follows:

§ 2.63 Action after response.

* * * * *

(b) *Final refusal or requirement*. Upon review of a response, the examining attorney may state that any refusal to register or requirement is final.

(1) If the examining attorney issues a final action that maintains any substantive refusal to register, the applicant may respond by timely filing:

(i) A request for reconsideration under paragraph (b)(3) of this section that seeks to overcome any substantive refusal to register, and comply with any outstanding requirement, maintained in the final action;

(ii) An appeal to the Trademark Trial and Appeal Board under §§ 2.141 and 2.142; or

(iii) A request for extension of time to respond or appeal under § 2.62(a)(2).

(2) If the examining attorney issues a final action that contains no substantive refusals to register, but maintains any requirement, the applicant may respond by timely filing:

- (i) A request for reconsideration under paragraph (b)(3) of this section that seeks to comply with any outstanding requirement maintained in the final action;
- (ii) An appeal of any requirement to the Trademark Trial and Appeal Board under §§ 2.141 and 2.142;
- (iii) A petition to the Director under § 2.146 to review any requirement, if the subject matter of the requirement is procedural, and therefore appropriate for petition; or
- (iv) A request for extension of time to respond or appeal under § 2.62(a)(2).

* * * * *

(c) *Denial of petition.* A requirement that is the subject of a petition decided by the Director may not subsequently be the subject of an appeal to the Trademark Trial and Appeal Board. If a petition to the Director under § 2.146 is denied, the applicant will have the later of:

- (1) The time remaining in the response period set forth in the Office action that repeated the requirement or made it final;
- (2) The time remaining after the filing of a timely request for extension of time to respond or appeal under § 2.62(a)(2); or
- (3) Thirty days from the date of the decision on the petition to comply with the requirement.

(d) *Amendment to allege use.* If an applicant in an application under section 1(b) of the Act files an amendment to allege use under § 2.76 during the response period after issuance of a final action, the examining attorney will examine the amendment. The filing of such an amendment does not stay or extend the time for filing an appeal or petition.

11. Amend § 2.65 by revising paragraph (a) to read as follows:

§ 2.65 Abandonment.

(a) An application will be abandoned if an applicant fails to respond to an Office action, or to respond completely, within the relevant time period for response under § 2.62(a), including any granted extension of time to respond under § 2.62(a)(2). A timely petition to the Director pursuant to §§ 2.63(a) and (b) and 2.146 or notice of appeal to the Trademark Trial and Appeal Board pursuant to § 2.142, if appropriate, is a response that avoids abandonment (see § 2.63(b)(4)).

(1) If all refusals and/or requirements are expressly limited to certain goods and/or services, the application will be abandoned only as to those goods and/or services.

(2) When a timely response by the applicant is a bona fide attempt to advance the examination of the application and is a substantially complete response to the examining attorney's action, but consideration of some matter or compliance with a requirement has been omitted, the examining attorney may grant the applicant 30 days, or to the end of the response period set forth in the action to which the substantially complete response was submitted, whichever is longer, to explain and supply the omission before the examining attorney considers the question of abandonment.

* * * * *

12. Amend § 2.66 by revising paragraph (b) to read as follows:

§ 2.66 Revival of applications abandoned in full or in part due to unintentional delay.

* * * * *

(b) *Petition to Revive Application Abandoned in Full or in Part for Failure to Respond to an Office Action.* A petition to revive an application abandoned in full or in part because the applicant did not timely respond to an Office action must include:

- (1) The petition fee required by § 2.6(a)(15);
- (2) A statement, signed by someone with firsthand knowledge of the facts, that the delay in filing the response on or before the due date was unintentional; and
- (3) A response to the Office action, signed pursuant to § 2.193(e)(2), or a statement that the applicant did not receive the Office action or the notification that an Office action issued. If the applicant asserts that the unintentional delay is based on non-receipt of an Office action or notification, the applicant may not assert non-receipt of the same Office action or notification in a subsequent petition.
- (4) If the Office action was subject to a three-month response period under § 2.62(a)(1), and the applicant does not assert non-receipt of the Office action or notification, the petition must also include the fee under § 2.6(a)(27) for a request for extension of time to respond under § 2.62(a)(2).
- (5) If the abandonment was after a final Office action, the response is treated as a request for reconsideration under § 2.63(b)(3), and the applicant must also file:
 - (i) A notice of appeal to the Trademark Trial and Appeal Board under § 2.141 or a petition to the Director under § 2.146, if permitted by § 2.63(b)(2)(iii); or
 - (ii) A statement that no appeal or petition is being filed from any final refusal or requirement.

* * * * *

13. Revise § 2.67 to read as follows:

§ 2.67 Suspension of action by the Patent and Trademark Office.

Action by the Office may be suspended for a reasonable time for good and sufficient cause. The fact that a proceeding is pending before the Office or a court that is relevant to the issue of initial or continued registrability of a mark and that proceeding has not been finally determined, or the fact that the basis for

registration is, under the provisions of section 44(e) of the Act, registration of the mark in a foreign country and the foreign application is still pending, will be considered prima facie good and sufficient cause. An Office or court proceeding is not considered finally determined until an order or ruling that ends the proceeding or litigation has been rendered and noticed, and the time for any appeal or other further review has expired with no further review sought. An applicant's request for a suspension of action under this section filed within the response period set forth in § 2.62(a) may be considered responsive to the previous Office action. The Office may require the applicant, registrant, or party to a proceeding to provide status updates and information relevant to the ground(s) for suspension, upon request.

14. Revise the undesignated center heading that precedes § 2.91 "CONCURRENT USE PROCEEDINGS" to read as follows:

***EX PARTE* EXPUNGEMENT AND REEXAMINATION**

15. Add § 2.91 to read as follows:

§ 2.91 Petition for expungement or reexamination.

(a) *Petition basis.* Any person may file a petition requesting institution of an ex parte proceeding to cancel a registration of a mark, in whole or in part, on one of the following bases:

(1) Expungement, if the mark is registered under sections 1, 44, or 66 of the Act and has never been used in commerce on or in connection with some or all of the goods and/or services recited in the registration; or

(2) Reexamination, if the mark is registered under section 1 of the Act and was not in use in commerce on or in connection with some or all of the goods and/or services recited in the registration on or before the relevant date, which for any particular goods and/or services, is determined as follows:

(i) In an application for registration of a mark with an initial filing basis of section 1(a) of the Act for the goods and/or services listed in the petition, and not amended at any point to be filed pursuant to section 1(b) of the Act, the relevant date is the filing date of the application; or

(ii) In an application for registration of a mark with an initial filing basis or amended basis of section 1(b) of the Act for the goods and/or services listed in the petition, the relevant date is the later of the filing date of an amendment to allege use identifying the goods and/or services listed in the petition, pursuant to section 1(c) of the Act, or the expiration of the deadline for filing a statement of use for the goods and/or services listed in the petition, pursuant to section 1(d), including all approved extensions thereof.

(b) *Time for filing.* The petition must be filed while the registration is in force and:

(1) Where the petition requests institution of an expungement proceeding under paragraph (a)(1) of this section, at any time following the expiration of 3 years after the date of registration and, for petitions made after December 27, 2023, before the expiration of 10 years following the date of registration; or

(2) Where the petition requests institution of a reexamination proceeding under paragraph (a)(2) of this section, at any time not later than 5 years after the date of registration.

(c) *Requirements for complete submission.* Only complete petitions under this section will be considered by the Director under § 2.92, and, once complete, may not be amended by the petitioner. A complete petition must be made in writing, timely filed through TEAS, and include the following:

(1) The fee required by § 2.6(a)(26);

(2) The U.S. trademark registration number of the registration subject to the petition;

- (3) The basis for petition under paragraph (a) of this section;
- (4) The name, domicile address, and email address of the petitioner;
- (5) If the domicile of the petitioner is not located within the United States or its territories, a designation of an attorney, as defined in § 11.1 of this chapter, who is qualified to practice under § 11.14 of this chapter;
- (6) If the petitioner is, or must be, represented by an attorney, as defined in § 11.1 of this chapter, who is qualified to practice under § 11.14 of this chapter, the attorney's name, postal address, email address, and bar information under § 2.17(b)(3);
- (7) Identification of each good and/or service recited in the registration for which the petitioner requests that the proceeding be instituted on the basis identified in the petition;
- (8) A verified statement that sets forth in numbered paragraphs:
 - (i) The elements of the reasonable investigation of nonuse conducted, as defined under paragraph (d) of this section, where for each source of information relied upon, the statement includes a description of how and when the searches were conducted and what the searches disclosed; and
 - (ii) A concise factual statement of the relevant basis for the petition, including any additional facts that support the allegation of nonuse of the mark in commerce on or in connection with the goods and services as specified in paragraph (a) of this section;
- (9) A clear and legible copy of all documentary evidence supporting a prima facie case of nonuse of the mark in commerce and an itemized index of such evidence. Evidence that supports a prima facie case of nonuse may also include, but is not limited to:
 - (i) Verified statements;

- (ii) Excerpts from USPTO electronic records in applications or registrations;
- (iii) Screenshots from relevant webpages, including the URL and access or print date;
- (iv) Excerpts from press releases, news articles, journals, magazines, or other publications, identifying the publication name and date of publication; and
- (v) Evidence suggesting that the verification accompanying a relevant allegation of use in the registration was improperly signed.

(d) *Reasonable investigation of nonuse.* A petitioner must make a bona fide attempt to determine if the registered mark was not in use in commerce or never in use in commerce on or in connection with the goods and/or services as specified in paragraph (a) of this section by conducting a reasonable investigation.

(1) A reasonable investigation is an appropriately comprehensive search, which may vary depending on the circumstances, but is calculated to return information about the underlying inquiry from reasonably accessible sources where evidence concerning use of the mark during the relevant time period on or in connection with the relevant goods and/or services would normally be found.

(2) Sources for a reasonable investigation may include, but are not limited to:

- (i) State and Federal trademark records;
- (ii) Internet websites and other media likely to or believed to be owned or controlled by the registrant;
- (iii) Internet websites, other online media, and publications where the relevant goods and/or services likely would be advertised or offered for sale;
- (iv) Print sources and webpages likely to contain reviews or discussion of the relevant goods and/or services;
- (v) Records of filings made with or of actions taken by any State or Federal business registration or regulatory agency;

- (vi) The registrant's marketplace activities, including, for example, any attempts to contact the registrant or purchase the relevant goods and/or services;
 - (vii) Records of litigation or administrative proceedings reasonably likely to contain evidence bearing on the registrant's use or nonuse of the registered mark;
 - and
 - (viii) Any other reasonably accessible source with information establishing nonuse of the mark as specified in paragraph (a) of this section.
- (3) A petitioner need not check all possible appropriate sources for its investigation to be considered reasonable.
- (e) *Director's authority.* The authority to act on petitions made under this section is reserved to the Director, and may be delegated.
- (f) *Oral hearings.* An oral hearing will not be held on a petition except when considered necessary by the Director.
- (g) *No stay.* The mere filing of a petition for expungement or reexamination by itself will not act as a stay in any appeal or inter partes proceeding that is pending before the Trademark Trial and Appeal Board, nor will it stay the period for replying to an Office action in any pending application or registration.

16. Add § 2.92 to read as follows:

§ 2.92 Institution of *ex parte* expungement and reexamination proceedings.

Notwithstanding section 7(b) of the Act, the Director may, upon a determination that information and evidence supports a prima facie case, institute a proceeding for expungement or reexamination of a registration of a mark, either upon petition or upon the Director's initiative. Information that supports a prima facie case of nonuse with the goods and/or services at issue shall be based upon all information and evidence available to the Office. The electronic record of the registration for

which a proceeding has been instituted forms part of the record of the proceeding without any action by the Office, a petitioner, or a registrant.

(a) *Institution upon petition.* For each good and/or service identified in a complete petition under § 2.91, the Director will determine if the petition sets forth a prima facie case of nonuse to support the petition basis and, if so, will institute an ex parte expungement or reexamination proceeding.

(b) *Institution upon the Director's initiative.* The Director may institute an ex parte expungement or reexamination proceeding on the Director's own initiative, within the time periods set forth in § 2.91(b), and for the reasons set forth in § 2.91(a), based on information that supports a prima facie case for expungement or reexamination of a registration for some or all of the goods or services identified in the registration.

(c) *Director's authority.* (1) Any determination by the Director whether to institute an expungement or reexamination proceeding shall be final and non-reviewable.

(2) The Director may institute an expungement and/or reexamination proceeding for fewer than all of the goods and/or services identified in a petition under § 2.91. The identification of particular goods and/or services in a petition does not limit the Director from instituting a proceeding that includes additional goods and/or services identified in the subject registration on the Director's own initiative, under paragraph (b) of this section.

(d) *Estoppel.* (1) Upon termination of an expungement proceeding under § 2.93(c)(3), including after any appeal, where it has been determined that the registered mark was used in commerce on or in connection with any of the goods and/or services at issue in the proceedings prior to the date a petition to expunge was filed under § 2.91 or the Director-initiated proceedings under § 2.92, no

further expungement proceedings may be instituted as to those particular goods and/or services.

(2) Upon termination of a reexamination proceeding under § 2.93(c)(3), including any appeal, where it is has been determined that the registered mark was used in commerce on or in connection with any of the goods and/or services at issue, on or before the relevant date established in the proceedings, no further expungement or reexamination proceedings may be instituted as to those particular goods and/or services.

(3) With respect to a particular registration, once an expungement proceeding has been instituted and is pending, no later expungement proceeding may be instituted with respect to the same goods and/or services at issue in the pending proceeding.

(4) With respect to a particular registration, while a reexamination proceeding is pending, no later expungement or reexamination proceeding may be instituted with respect to the same goods and/or services at issue in the pending proceeding.

(e) *Consolidated proceedings.*

(1) The Director may consolidate expungement and reexamination proceedings involving the same registration. Consolidated proceedings will be considered related parallel proceedings.

(2) If two or more petitions under § 2.91 are directed to the same registration and are pending concurrently, or the Director wishes to institute an ex parte expungement or reexamination proceeding on the Director's own initiative under paragraph (b) of this section concerning a registration for which one or more petitions under § 2.91 are pending, the Director may elect to institute a single proceeding.

(3) Unless barred under paragraph (d) of this section, if any expungement or reexamination proceeding is instituted while a prior expungement or

reexamination proceeding directed to the same registration is pending, the Director may consolidate the proceedings.

(f) Notice of Director's determination whether to institute proceedings. (1) In a determination based on a petition under § 2.91, if the Director determines that no prima facie case of nonuse has been made and thus no proceeding will be instituted, notice of this determination will be provided to the registrant and petitioner, and will include the means to access the petition and supporting documents and evidence.

(2) If the Director determines that a proceeding should be instituted based on a prima facie case of nonuse of a registered mark as to any goods and/or services recited in the registration, or consolidates proceedings under paragraph (e) of this section, the Director's determination and notice of the institution of the proceeding will be set forth in an Office action under § 2.93(a). If a proceeding is instituted based in whole or in part on a petition under § 2.91, the Office action will include the means to access any petition and the supporting documents and evidence supporting a prima facie case that formed the basis for the Director's determination. Notice of the Director's determination will also be provided to the petitioner.

(g) Other mark types. (1) Registrations subject to expungement and reexamination proceedings include collective trademarks, collective service marks, and certification marks.

(2) The use that is the subject of the inquiry in expungement and reexamination proceedings for these mark types is defined in § 2.2(k)(2) for collective trademarks and collective service marks, and § 2.2(k)(4) for certification marks.

17. Add § 2.93 to read as follows:

§ 2.93 Expungement and reexamination procedures.

(a) *Office action*. An Office action issued to a registrant pursuant to § 2.92(f)(2) will require the registrant to provide such evidence of use, information, exhibits, affidavits, or declarations as may be reasonably necessary to rebut the prima facie case of nonuse by establishing that the required use in commerce has been made on or in connection with the goods and/or services at issue as of the date relevant to the proceeding. The Office action may also include requirements under §§ 2.11, 2.23, and 2.189, as appropriate.

(b) *Response*—(1) *Deadline*. The registrant's response to an Office action must be received by the Office within two months from the issue date. If the registrant fails to timely respond to a non-final Office action, the proceeding will terminate, and the registration will be cancelled as to the relevant goods and/or services.

(2) *Signature*. The response must be signed by the registrant, someone with legal authority to bind the registrant (e.g., a corporate officer or general partner of a partnership), or a practitioner qualified to practice under § 11.14 of this chapter, in accordance with the requirements of § 2.193(e)(2).

(3) *Form*. Responses must be submitted through TEAS. Responses sent via email or facsimile will not be accorded a date of receipt.

(4) *Response in an expungement proceeding*. In an expungement proceeding, an acceptable response consists of one or more of the following:

(i) Evidence of use, in accordance with paragraph (b)(6) of this section, establishing that use of the mark in commerce occurred on or in connection with the goods and/or services at issue either before the filing date of the relevant granted petition to expunge under § 2.91(a)(1) or before the date the proceeding was instituted by the Director under § 2.92(b), as appropriate;

(ii) Verified statements and supporting evidence to establish that any nonuse as to particular goods and/or services with a sole basis under section 44(e) or section 66(a) of the Act is due to special circumstances that excuse such nonuse; and/or

(iii) Deletion of some or all of the goods and/or services at issue in the proceeding, if appropriate, subject to the provisions of paragraph (d) of this section.

(5) *Response in a reexamination proceeding.* In a reexamination proceeding, an acceptable response consists of one or more of the following:

(i) Evidence of use, in accordance with paragraph (b)(6) of this section, establishing that use of the mark in commerce occurred on or in connection with each particular good and/or service at issue, on or before the relevant date set forth in § 2.91(a)(2); and/or

(ii) Deletion of some or all of the goods and/or services at issue in the proceeding, if appropriate, subject to the provisions of paragraph (d) of this section.

(6) *Evidence of use.* Evidence of use of the mark in commerce on or in connection with any particular good and/or service must be consistent with the definition of “use in commerce” set forth in section 45 of the Act and is not limited in form to that of specimens under § 2.56. Any evidence of use must be accompanied by a verified statement setting forth in numbered paragraphs factual information about the use of the mark in commerce and the supporting evidence, including how the evidence demonstrates use of the mark in commerce as of any relevant date for the goods and/or services at issue. Evidence must be labeled, and an itemized index of the evidence must be provided such that the particular goods and/or services supported by each item submitted as evidence of use is clear.

(c) *Action after response.* After response by the registrant, the Office will review the registrant's evidence of use or showing of applicable excusable nonuse, and/or arguments, and determine compliance with any requirement.

(1) *Final Office action.* If the registrant's timely response fails to rebut the prima facie case of nonuse or fully comply with all outstanding requirements, a final Office action will issue that addresses the evidence, includes the examiner's decision, and maintains any outstanding requirement. After issuance of a final Office action, the registrant may respond by timely filing:

(i) A request for reconsideration of the final Office action that seeks to further address the issue of use of the mark in commerce and/or comply with any outstanding requirement maintained in the final action; or

(ii) An appeal to the Trademark Trial and Appeal Board under § 2.143.

(2) *Time for filing a request for reconsideration or petition to the Director.* (i) A request for reconsideration must be filed prior to the expiration of time provided for an appeal in § 2.143. Filing a request for reconsideration does not stay or extend the time for filing an appeal or a petition under paragraph (c)(2)(iv) of this section.

(ii) Prior to the expiration of time for filing an appeal to the Trademark Trial and Appeal Board under § 2.143, a registrant may file a petition to the Director under § 2.146 for relief from any outstanding requirement under §§ 2.11, 2.23, and 2.189 made final. If the petition is denied, the registrant will have 2 months from the date of issuance of the final action that contained the final requirement, or 30 days from the date of the decision on the petition, whichever date is later, to comply with the requirement. A requirement that is the subject of a petition decided by the Director may not subsequently be the subject of an appeal to the Trademark Trial and Appeal Board.

(3) *Termination of proceeding.* (i) If, upon review of any timely response, the Office finds that the registrant has rebutted the prima facie case of nonuse and complied with all outstanding requirements, the proceeding will terminate and a notice of termination shall be issued under § 2.94.

(ii) If, after issuance of the final action, the registrant fails to timely comply with any outstanding requirement, or the Office finds that the registrant has failed to rebut the prima facie case of nonuse of the mark on or in connection with any of the goods and/or services at issue in the proceeding, the proceeding will terminate, and a notice of termination shall be issued under § 2.94 after the time for appeal has expired or any appeal proceeding has terminated, pursuant to §§ 2.143-2.145.

(d) *Deletion of goods and/or services.* The registrant may respond to an Office action under this section by requesting that some or all of the goods and/or services at issue in the proceeding be deleted from the registration. No other amendment to the identification of goods or services in a registration will be permitted in a response.

(1) An acceptable deletion requested in a response under this section shall be immediate in effect, and reinsertion of goods and/or services or further amendments that would add to or expand the scope of the goods and/or services shall not be permitted. Deletion of goods and/or services in an expungement or reexamination proceeding after the submission and prior to the acceptance of an affidavit or declaration under section 8 or 71 of the Act will result in a fee under § 2.161(c) or § 7.37(c).

(2) A submission other than one made under this section, including a request to surrender the subject registration for cancellation under § 2.172 or a request to amend the registration under § 2.173, filed after the issuance of an Office action

under this section, does not constitute a sufficient response to an Office action under this section. The registrant must notify the Office of such submission in a timely response.

(3) Deletion of goods and/or services at issue in a pending proceeding in a response, a surrender for cancellation under § 2.172, an amendment of the registration under § 2.173, or any other accepted submission, shall render the proceeding moot as to those goods and/or services, and no further determination will be made regarding the registrant's use of the mark in commerce as to those goods and/or services.

18. Add § 2.94 to read as follows:

§ 2.94 Action after expungement or reexamination.

Upon termination of an expungement or reexamination proceeding, the Office shall issue a notice of termination that memorializes the final disposition of the proceeding as to each of the goods and/or services at issue in the proceeding. Where appropriate, the registration will be cancelled, in whole or in part, based on the final disposition of the proceeding.

19. Add an undesignated center heading that precedes § 2.99 to read as follows:

CONCURRENT USE PROCEEDINGS

20. Revise the undesignated center heading that precedes § 2.111 "CANCELLATION" to read as follows:

**CANCELLATION PROCEEDINGS BEFORE THE TRADEMARK TRIAL
AND APPEAL BOARD**

21. Amend § 2.111 by revising paragraph (b) to read as follows:

§ 2.111 Filing petition for cancellation.

* * * * *

(b) Any person who believes that he, she, or it is or will be damaged by a registration may file a petition, addressed to the Trademark Trial and Appeal Board, for cancellation of the registration in whole or in part. The petition for cancellation need not be verified, but must be signed by the petitioner or the petitioner's attorney, as specified in § 11.1 of this chapter, or other authorized representative, as specified in § 11.14(b) of this chapter. Electronic signatures pursuant to § 2.193(c) are required for petitions submitted electronically via ESTTA. The petition for cancellation may be filed at any time in the case of registrations on the Supplemental Register or under the Act of 1920, or registrations under the Act of 1881 or the Act of 1905, which have not been published under section 12(c) of the Act, on any ground specified in section 14(3) or section 14(5) of the Act, or at any time after the three-year period following the date of registration on the ground specified in section 14(6) of the Act. In all other cases, including nonuse claims not specified in section 14(6), the petition for cancellation and the required fee must be filed within five years from the date of registration of the mark under the Act or from the date of publication under section 12(c) of the Act.

* * * * *

22. Amend § 2.117 by revising paragraph (a) to read as follows:

§ 2.117 Suspension of proceedings.

(a) Whenever it shall come to the attention of the Trademark Trial and Appeal Board that a civil action, another Board proceeding, or an expungement or reexamination proceeding may have a bearing on a pending case, proceedings before the Board may be suspended until termination of the civil action, the other Board proceeding, or the expungement or reexamination proceeding. A civil

action or proceeding is not considered to have been terminated until an order or ruling that ends litigation has been rendered and noticed and the time for any appeal or other further review has expired with no further review sought.

* * * * *

23. Revise § 2.141 to read as follows:

§ 2.141 *Ex parte* appeals from refusal to register by action of trademark examining attorney.

(a) An applicant may, upon final refusal to register by the trademark examining attorney, appeal to the Trademark Trial and Appeal Board upon payment of the prescribed fee for each class in the application for which an appeal is taken, within the time provided in § 2.62(a), including any granted extension of time to respond or appeal under § 2.62(a)(2). A second refusal to register on the same grounds may be considered as final by the applicant for purpose of appeal.

(b) The applicant must pay an appeal fee for each class from which the appeal is taken. If the applicant does not pay an appeal fee for at least one class of goods or services before expiration of the filing period, the application will be abandoned. In a multiple-class application, if an appeal fee is submitted for fewer than all classes, the applicant must specify the class(es) in which the appeal is taken. If the applicant timely submits a fee sufficient to pay for an appeal in at least one class, but insufficient to cover all the classes, and the applicant has not specified the class(es) to which the fee applies, the Board will issue a written notice setting a time limit in which the applicant may either pay the additional fees or specify the class(es) being appealed. If the applicant does not submit the required fee or specify the class(es) being appealed within the set time period, the Board will apply the fee(s) to the class(es) in ascending order, beginning with the lowest numbered class containing goods and/or services at issue in the appeal.

24. Amend § 2.142 by revising paragraphs (a), (b)(3), and (d) to read as follows:

§ 2.142 Time and manner of *ex parte* appeals.

(a) Any appeal filed under the provisions of § 2.141 must be filed within the time provided in § 2.62(a), including any granted extension of time to respond or appeal under § 2.62(a)(2). An appeal is taken by filing a notice of appeal, as prescribed in § 2.126, and paying the appeal fee.

(b) * * *

(3) Citation to evidence in briefs should be to the documents in the electronic record for the subject application or registration by date, the name of the paper under which the evidence was submitted, and the page number in the electronic record.

* * * * *

(d) The evidentiary record in the proceeding should be complete prior to the filing of an appeal. Evidence should not be filed with the Board after the filing of a notice of appeal.

(1) In an appeal from a refusal to register, if the appellant or the examining attorney desires to introduce additional evidence after an appeal is filed, the appellant or the examining attorney must submit a request to the Board to suspend the appeal and to remand the application for further examination.

(2) In an appeal from an expungement or reexamination proceeding, no additional evidence may be included once an appeal is initiated, and the Board may not remand for further examination.

* * * * *

25. Add § 2.143 to read as follows:

§ 2.143 *Ex parte* appeals from expungement or reexamination proceeding.

(a) A registrant may, upon issuance of a final Office action in an expungement or reexamination proceeding under § 2.93, appeal to the Trademark Trial and Appeal Board by filing a notice of appeal, as prescribed in § 2.126, and upon payment of the prescribed fee for each class in the registration for which the appeal is taken, within two months of the date of issuance of the final Office action. If the registrant does not pay an appeal fee for at least one class of goods or services before expiration of the time for appeal, the Office shall terminate the appeal proceeding. In a multiple-class registration, if an appeal fee is submitted for fewer than all classes, the registrant must specify the class(es) in which the appeal is taken. If the registrant timely submits a fee sufficient to pay for an appeal in at least one class, but insufficient to cover all the classes, and the registrant has not specified the class(es) to which the fee applies, the Board will issue a written notice setting a time limit in which the registrant may either pay the additional fees or specify the class(es) being appealed. If the registrant does not submit the required fee or specify the class(es) being appealed within the set time period, the Board will apply the fee to the class(es) in ascending order, beginning with the lowest numbered class containing goods and/or services at issue in the reexamination and/or expungement proceeding.

(b) The time and manner of ex parte appeals made under paragraph (a) of this section shall, in all other respects, follow the time and manner set forth in § 2.142(b)-(e).

26. Amend § 2.145 by revising paragraphs (a)(1) and (c)(1) to read as follows:

§ 2.145 Appeal to court and civil action.

(a) * * * (1) An applicant for registration, a registrant in an expungement or reexamination proceeding, or any party to an interference, opposition, or cancellation, or any party to an application to register as a concurrent user,

hereinafter referred to as inter partes proceedings, who is dissatisfied with the decision of the Trademark Trial and Appeal Board, and any registrant who has filed an affidavit or declaration under section 8 or section 71 of the Act or filed an application for renewal, and is dissatisfied with the decision of the Director (§§ 2.165, 2.184), may appeal to the United States Court of Appeals for the Federal Circuit. It is unnecessary to request reconsideration by the Board before filing any such appeal; however, a party requesting reconsideration must do so before filing a notice of appeal.

* * * * *

(c) * * * (1) Any person who may appeal to the United States Court of Appeals for the Federal Circuit (paragraph (a) of this section), except for a registrant subject to an ex parte expungement or reexamination proceeding, may have remedy by civil action under section 21(b) of the Act. It is unnecessary to request reconsideration by the Board before filing any such civil action; however, a party requesting reconsideration must do so before filing a civil action.

* * * * *

27. Amend § 2.146 by:

- a.** Revising paragraphs (b) and (c), and
- b.** Adding paragraph (d)(2)(iv).

The revision and addition read as follows:

§ 2.146 Petitions to the Director.

* * * * *

(b) Questions of substance arising during the ex parte prosecution of applications, or expungement or reexamination of registrations, including, but not limited to, questions arising under sections 2, 3, 4, 5, 6, 16A, 16B, and 23 of the Act of 1946, are not appropriate subject matter for petitions to the Director.

(c)(1) Every petition to the Director shall include a statement of the facts relevant to the petition, the points to be reviewed, the action or relief requested, and the fee required by § 2.6. Any brief in support of the petition shall be embodied in or accompany the petition. The petition must be signed by the petitioner, someone with legal authority to bind the petitioner (e.g., a corporate officer or general partner of a partnership), or a practitioner qualified to practice under § 11.14 of this chapter, in accordance with the requirements of § 2.193(e)(5). When facts are to be proved on petition, the petitioner must submit proof in the form of verified statements signed by someone with firsthand knowledge of the facts to be proved, and any exhibits.

(2) A petition requesting reinstatement of a registration cancelled in whole or in part for failure to timely respond to an Office action issued in an expungement and/or reexamination proceeding must include a response to the Office action, signed in accordance with § 2.193.

(d) * * *

(2) * * *

(iv) Where an expungement or reexamination proceeding has been instituted under § 2.92, two months after the date of actual knowledge of the cancellation of goods and/or services in a registration and not later than six months after the date the trademark electronic record system indicates that the goods and/or services are cancelled.

28. Amend § 2.149 by revising paragraphs (a) and (i) to read as follows:

§ 2.149 Letters of protest against pending applications.

(a) A third party may submit, for consideration and inclusion in the record of a trademark application, objective evidence relevant to the examination of the application for a ground for refusal of registration if the submission is made in accordance with this section.

* * * * *

(i) Any determination whether to include evidence in the record of an application in a submission under this section is final and non-reviewable, and a determination to include or not include evidence in the application record shall not prejudice any party's right to raise any issue and rely on any evidence in any other proceeding.

* * * * *

29. Amend § 2.163 by:

- a. Revising paragraphs (b) and (c), and
- b. Adding paragraphs (d) and (e).

The revisions and additions read as follows:

§ 2.163 Acknowledgment of receipt of affidavit or declaration.

* * * * *

(b) A response to the refusal must be filed within three months of the date of issuance of the Office action, or before the end of the filing period set forth in section 8(a) of the Act, whichever is later. The response must be signed by the owner, someone with legal authority to bind the owner (e.g., a corporate officer or general partner of a partnership), or a practitioner qualified to practice under § 11.14 of this chapter, in accordance with the requirements of § 2.193(e)(2).

(c) Unless notified otherwise in the Office action, the three-month response period designated in paragraph (b) of this section may be extended by three months up to a maximum of six months from the Office action issue date, upon timely request and payment of the fee set forth in § 2.6(a)(27). To be considered timely, a request for extension of time must be received by the Office on or before the deadline for response set forth in the Office action.

(d) When a timely response is a bona fide attempt to advance the examination of the affidavit or declaration and is a substantially complete response to the outstanding Office action, but consideration of some matter or compliance with a requirement has

been omitted, the owner may be granted 30 days, or to the end of the response period set forth in the action to which the substantially complete response was submitted, whichever is longer, to explain and supply the omission before the cancellation is considered.

(e) If no response is filed within the time periods set forth above, the registration will be cancelled, unless time remains in the grace period under section 8(a)(3) of the Act. If time remains in the grace period, the owner may file a complete new affidavit.

30. Revise § 2.165 to read as follows:

§ 2.165 Petition to Director to review refusal.

(a) A response to the examiner's initial refusal to accept an affidavit or declaration is required before filing a petition to the Director, unless the examiner directs otherwise. See § 2.163(b)-(c) for the deadline for responding to an examiner's Office action.

(b) If the examiner maintains the refusal of the affidavit or declaration, the owner may file a petition to the Director to review the action. The petition must be filed within three months of the date of issuance of the action maintaining the refusal.

(c) Unless notified otherwise in the Office action, the time for response designated in paragraph (b) of this section may be extended by three months up to a maximum of six months from the Office action issue date, upon timely request and payment of the fee set forth in § 2.6(a)(27). To be considered timely, a request for extension of time must be received by the Office on or before the deadline for response set forth in the Office action.

(d) If no response is filed within the time periods set forth above, the registration will be cancelled and a notice of cancellation will issue.

(e) A decision by the Director is necessary before filing an appeal or commencing a civil action in any court.

31. Add an undesignated center heading before § 2.177 to read as follows:

COURT ORDERS UNDER SECTION 37

32. Add § 2.177 to read as follows:

§ 2.177 Action on court order under section 37.

(a) *Providing the order to the Office.* If a Federal court has issued an order concerning a registration under section 37 of the Act, a party to the court action must:

(i) Submit a certified copy of the order to the Director, addressed to the Office of the General Counsel, as provided in § 104.2 of this chapter; and

(ii) If the party is aware of proceedings concerning the involved registration that are pending or suspended before the Trademark Trial and Appeal Board, file a copy of such order with the Trademark Trial and Appeal Board via ESTTA.

(b) *Time for submission.* A submission under paragraph (a) of this section should not be made until after the court proceeding has been finally determined. A court proceeding is not considered finally determined until an order or ruling that ends the litigation has been rendered and noticed, and the time for any appeal or other further review has expired with no further review sought.

(c) *Action after submission.* After the court proceeding has been finally determined, appropriate action on a court order submitted under this section will normally be taken by the Office without the necessity of any submission by an interested party. In circumstances where the Director or the Trademark Trial and Appeal Board, if the order under section 37 involves a registration over which the Board has jurisdiction, determines that it would be helpful to aid in understanding the scope or effect of the court's order, a show cause or other order may issue directing the registrant, and if appropriate, the opposing parties to the action from which the order arose, to respond and provide information or arguments regarding the order. The Director may also request clarification of the order from the court that issued the order.

33. Amend § 2.184 by revising paragraph (b) to read as follows:

§ 2.184 Refusal of renewal.

* * * * *

(b)(1) The registrant must file a response to the refusal of renewal within three months of the date of issuance of the Office action or before the expiration date of the registration, whichever is later.

(2) Unless notified otherwise in the Office action, the three-month response period designated in paragraph (b)(1) of this section may be extended by three months up to a maximum of six months from the Office action issue date, upon timely request and payment of the fee set forth in § 2.6(a)(27). To be considered timely, a request for extension of time must be received by the Office on or before the deadline for response set forth in the Office action.

(3) When a timely response is a bona fide attempt to advance the examination of the renewal application and is a substantially complete response to the outstanding Office action, but consideration of some matter or compliance with a requirement has been omitted, the owner may be granted 30 days, or to the end of the response period set forth in the action to which the substantially complete response was submitted, whichever is longer, to explain and supply the omission before the expiration is considered.

(4) If no response is filed within the time periods set forth above, the registration will expire, unless time remains in the grace period under section 9(a) of the Act. If time remains in the grace period, the registrant may file a complete new renewal application.

(5) The response must be signed by the registrant, someone with legal authority to bind the registrant (e.g., a corporate officer or general partner of a partnership), or a

practitioner who meets the requirements of § 11.14 of this chapter, in accordance with the requirements of § 2.193(e)(2).

* * * * *

34. Amend § 2.186 by:

- a. Revising paragraphs (b) and (c), and
- b. Adding paragraphs (d) and (e).

The revisions and additions read as follows:

§ 2.186 Petition to Director to review refusal of renewal.

* * * * *

(b) If the examiner maintains the refusal of the renewal application, a petition to the Director to review the refusal may be filed. The petition must be filed within three months of the date of issuance of the Office action maintaining the refusal.

(c) Unless notified otherwise in the Office action, the three-month response period designated in paragraph (b) of this section may be extended by three months up to a maximum of six months from the Office action issue date, upon timely request and payment of the fee set forth in § 2.6(a)(27). To be considered timely, a request for extension of time must be received by the Office on or before the deadline for response set forth in the Office action.

(d) If no response is filed within the time periods set forth above, the renewal application will be abandoned and the registration will expire.

(e) A decision by the Director is necessary before filing an appeal or commencing a civil action in any court.

35. Amend § 2.193 by revising paragraph (e)(5) introductory text to read as follows:

§ 2.193 Trademark correspondence and signature requirements.

* * * * *

(e) * * *

(5) *Petitions to Director under § 2.146 or § 2.147 or for expungement or reexamination under § 2.91.* A petition to the Director under § 2.146 or § 2.147 or for expungement or reexamination under § 2.91 must be signed by the petitioner, someone with legal authority to bind the petitioner (e.g., a corporate officer or general partner of a partnership), or a practitioner qualified to practice under § 11.14 of this chapter, in accordance with the following guidelines:

* * * * *

**PART 7 - RULES OF PRACTICE IN FILINGS PURSUANT TO THE
PROTOCOL RELATING TO THE MADRID AGREEMENT CONCERNING
THE INTERNATIONAL REGISTRATION OF MARKS**

36. The authority citation for part 7 is revised to read as follows:

Authority: 15 U.S.C. 1123, 35 U.S.C. 2, Pub. L. 116-260, 134 Stat. 1182, unless otherwise noted.

37. Amend § 7.6 by adding paragraph (a)(9) to read as follows:

§ 7.6 Schedule of U.S. process fees.

(a) * * *

(9) *Extension of time for filing a response to an Office action under §§ 7.39(b) or 7.40(c).*

(i) For filing a request for extension of time for filing a response to an Office action under §§ 7.39(b) or 7.40(c) on paper—\$225.00

(ii) For filing a request for extension of time for filing a response to an Office action under §§ 7.39(b) or 7.40(c) via TEAS—\$125.00

* * * * *

38. Revise § 7.39 to read as follows:

§ 7.39 Acknowledgment of receipt of and correcting deficiencies in affidavit or declaration of use in commerce or excusable nonuse.

The Office will issue a notice as to whether an affidavit or declaration is acceptable, or the reasons for refusal.

(a) A response to the refusal must be filed within three months of the date of issuance of the Office action, or before the end of the filing period set forth in section 71(a) of the Act, whichever is later. The response must be signed by the holder, someone with legal authority to bind the holder (e.g., a corporate officer or general partner of a partnership), or a practitioner qualified to practice under § 11.14 of this chapter, in accordance with the requirements of § 2.193(e)(2).

(b) Unless notified otherwise in the Office action, the three-month response period designated in paragraph (a) of this section may be extended by three months up to a maximum of six months from the Office action issue date, upon timely request and payment of the fee set forth in § 7.6(a)(9). To be considered timely, a request for extension of time must be received by the Office on or before the deadline for response set forth in the Office action.

(c) When a timely response is a bona fide attempt to advance the examination of the affidavit or declaration and is a substantially complete response to the outstanding Office action, but consideration of some matter or compliance with a requirement has been omitted, the holder may be granted 30 days, or to the end of the response period set forth in the action to which the substantially complete response was submitted, whichever is longer, to explain and supply the omission before the cancellation is considered.

(d) If no response is filed within this time period, the extension of protection will be cancelled, unless time remains in the grace period under section 71(a)(3) of the Act. If time remains in the grace period, the holder may file a complete, new affidavit.

(e) If the affidavit or declaration is filed within the time periods set forth in section 71 of the Act, deficiencies may be corrected after notification from the Office, as follows:

(1) Correcting deficiencies in affidavits or declarations timely filed within the periods set forth in sections 71(a)(1) and 71(a)(2) of the Act. If the affidavit or declaration is timely filed within the relevant filing period set forth in section 71(a)(1) or section 71(a)(2) of the Act, deficiencies may be corrected before the end of this filing period without paying a deficiency surcharge. Deficiencies may be corrected after the end of this filing period with payment of the deficiency surcharge required by section 71(c) of the Act and § 7.6.

(2) Correcting deficiencies in affidavits or declarations filed during the grace period. If the affidavit or declaration is filed during the six-month grace period provided by section 71(a)(3) of the Act, deficiencies may be corrected before the expiration of the grace period without paying a deficiency surcharge. Deficiencies may be corrected after the expiration of the grace period with payment of the deficiency surcharge required by section 71(c) of the Act and § 7.6.

(f) If the affidavit or declaration is not filed within the time periods set forth in section 71 of the Act, the registration will be cancelled.

39. Revise § 7.40 to read as follows:

§ 7.40 Petition to Director to review refusal.

(a) A response to the examiner's initial refusal to accept an affidavit or declaration is required before filing a petition to the Director, unless the examiner directs otherwise. See § 7.39(b)-(c) for the deadline for responding to an examiner's Office action.

(b) If the examiner maintains the refusal of the affidavit or declaration, the holder may file a petition to the Director to review the examiner's action. The petition must be filed within three months of the date of issuance of the action maintaining the refusal.

(c) Unless notified otherwise in the Office action, the three-month response period designated in paragraph (b) of this section may be extended by three months up to a maximum of six months from the Office action issue date, upon timely request and payment of the fee set forth in § 7.6(a)(9). To be considered timely, a request for extension of time must be received by the Office on or before the deadline for response set forth in the Office action.

(d) If no response is filed within the time periods set forth above, the registration will be cancelled.

(e) A decision by the Director is necessary before filing an appeal or commencing a civil action in any court.

Andrew Hirshfeld,

Commissioner for Patents,

Performing the Functions and Duties of the Under Secretary of Commerce for

Intellectual Property and Director of the United States Patent and Trademark Office.

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